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No. 95-

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

EDWARD L. GUSSIN,
Petitioner,

v.

NINTENDO OF AMERICA, INC.
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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November 1, 1995

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QUESTION PRESENTED

Whether the Court of Appeals for the Federal Circuit erred in holding that, notwithstanding the Seventh Amendment, a court may construe a patent claim as a matter of law and decide questions of patent infringement, even when there are genuine factual disputes surrounding both the interpretation of the patent claim and the question of infringement.

PARTIES TO THE PROCEEDING

Petitioner, Edward J. Gussin, was the appellant in the Court of Appeals and the plaintiff in the District Court. Respondent Nintendo of America, Inc., was the appellee in the Court of Appeals and the defendant in the District Court.

There are no other parties to the case.

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EDWARD L. GUSSIN,

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NINTENDO OF AMERICA, INC.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Edward J. Gussin petitions for review of the decision of the United States Court of Appeals for the Federal Circuit holding that the existence of genuine issues of material fact regarding interpretation of a patent claim and regarding other questions of infringement does not preclude summary judgment because such matters may be deemed issues of "law" amenable to summary judgment. The Federal Circuit premised its holding on *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (in banc), which this Court subsequently granted certiorari to review. *See Markman v. Westview Instruments, Inc.*, No. 95-26 (cert. granted Sept. 27, 1995). A writ of certiorari should similarly issue in this case, or — at the very least — this Court should hold the instant petition in abeyance pending its disposition of the *Markman* case.

OPINIONS BELOW

The opinion of the Court of Appeals (Pet. App. 2a-11a) is unreported. The decision of the District Court (Pet. App. 12a-39a) is reported at 33 U.S.P.Q.2d (BNA) 1418 (C.D. Cal. 1994).

JURISDICTION

The judgment of the Court of Appeals was entered on August 3, 1995. Pet. App. 2a. Timely petitions for rehearing were denied on August 30, 1995. Pet. App. 1a. The jurisdiction of this Court is invoked pursuant to 28 U.S.C. § 1254(1).

CONSTITUTIONAL PROVISION

The Seventh Amendment to the United States Constitution provides:

> In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law.

STATEMENT OF THE CASE

This case presents the question of whether a court may, consistent with the Seventh Amendment, deny a jury the opportunity to decide disputed factual questions surrounding a patent claim, which defines the scope of a patentee's rights, as well as related factual issues concerning patent infringement. Relying on its previous decision in *Markman*, the Federal Circuit held in the instant case that the Seventh Amendment permits such disputed factual questions to be re-classified as "legal" ones; to be withdrawn from the jury; and to be decided by a court on summary judgment. The decision below will have a dramatic impact on patent litigation throughout the Nation and plainly warrants this Court's review. At the very least, the instant petition should be held pending this Court's decision in *Markman*.

1. *The Patent*. Petitioner Edward L. Gussin was granted U.S. Patent 4,782,335 (the '335 patent) entitled "Video Art Electronic System" on November 1, 1988. As noted in the file history of the patent, Gussin's invention is an "apparatus for

drawing images in color . . . on a television receiver that a child can operate." Court of Appeals Appendix ("C.A. App.") 170.[1] The patent contained sixteen separate numbered claims. Pet. App. 13a. At issue here are independent claims 1 and 2.

2. *The Accused System.* Respondent Nintendo sells the "Super Nintendo Entertainment System" (SNES), a home video entertainment system that allows a user to play an assortment of video game cartridges on an ordinary television receiver. One such game cartridge that Nintendo developed is "Mario Paint." Like Gussin's invention, the Mario Paint cartridge and the SNES allow a user to draw and color pictures on an ordinary home TV set.

3. *District Court Litigation.* On July 21, 1993, petitioner filed a patent infringement action in the U.S. District Court for the Central District of California pursuant to 35 U.S.C. § 281. The complaint alleged that the SNES, when used in conjunction with Mario Paint, infringes on the '335 Patent, and sought money damages under 35 U.S.C. § 284. The District Court had jurisdiction pursuant to 28 U.S.C. § 1338(a).

The thrust of Gussin's argument was that both his patented system and Nintendo's SNES/Mario Paint combination are video art electronic systems intended for attachment to an ordinary color TV set. In fact, prior to the judgment in this case, Gussin had licensed Sony and two other video game manufacturers under the '335 patent, including one that made cartridges for use with Nintendo games. C.A. App. 238.

On March 28, 1994, Nintendo moved for summary judgment on grounds of noninfringement, pursuant to Fed. R. Civ. P. 56(d). In opposition, Gussin filed a declaration of patent expert James E. Brunton; a declaration by Gussin himself (he had previously been qualified as an expert and had testified in that

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[1] On November 20, 1992, the U.S. Patent and Trademark Office (PTO) granted a request for reexamination of the '335 patent in view of several prior art references. A reexamination certificate issued on September 21, 1993, indicating that claim 1 had been confirmed and claim 2 had been allowed after certain amendments.

capacity at two trials involving video game patents other than his own, C.A. App. 485); other documentary evidence; and numerous admissions by Nintendo. Petitioner's submission demonstrated the existence of disputed issues of material fact regarding virtually every aspect of the case.

4. *The District Court's Decision.* The District Court disregarded the disputed issues of fact identified by petitioner and proceeded to construe Gussin's patent claim as a matter of law. The court granted summary judgment to Nintendo on the basis of the court's conclusion that "the '335 Patent, properly construed in light of the literal claim and specification language and the prosecution history, contains four essential limitations that are not present in the accused device." Pet. App. 18a.

a. First, the District Court asserted that "Gussin's patent is limited to a 'dedicated hardware device,' whereas the accused device is a 'programmable computer' that is dependent upon software." *Id.* Yet the word "dedicated" appears nowhere in Gussin's claims or in any argument made by Gussin to the Patent and Trademark Office ("PTO") to distinguish these claims from the prior art. The District Court simply adopted wholesale the disputed conclusions of Nintendo's expert and rejected Gussin's conflicting declaration,[2] together with the testimony of

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[2] Gussin stated:

> 9. . . . The accused SNES/MARIO PAINT combination is a dedicated hardware/firmware device, and is not a programmable computer like Macintosh and IBM PC computers. Such computers have keyboards for input, CRT screens for display, and disk drives to load disks and to run programs or to create and/or modify programs. Neither the SNES nor MARIO PAINT has any of these characteristics of a computer. The SNES console has no keyboard for input, not CRT for display, and no disk drives. The MARIO PAINT ROM cartridge is firmware, and cannot be reprogrammed in whole or in part. In fact, with the MARIO PAINT ROM cartridge inserted into the SNES console, a user cannot insert any other cartridge into the SNES console. For these reasons, my claims 1 and 2 cover the MARIO PAINT combination literally. . . .

Gussin's patent expert, who explained that Gussin's patent covered cartridge/console drawing systems. C.A. App. 802-03.

The District Court interpreted Gussin's patent based on a tendentious and disputed reading of an argument that Gussin had made in the PTO regarding a *different* cartridge-driven device that did *not* permit drawing.[3] The court simply disregarded Nintendo's own admissions that the SNES/Mario Paint combination is neither a "personal computer" nor a "general purpose computer" and that the Nintendo system is not intended

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> 10. I have examined the SNES hardware console, the MARIO PAINT firmware ROM cartridge, and the SNES/MARIO PAINT hardware/firmware system. Neither the SNES console nor the MARIO PAINT ROM cartridge is programmable. Neither can be re-programmed by a user. Like the video art electronic systems claimed in the '335 patent, Nintendo's SNES/MARIO PAINT combination is: simple enough for children to use, unprogrammable, and a dedicated, firmware/hardware system. These systems are sold primarily in kids' stores such as Toys 'R Us and KB Stores. By contrast, true computers such as Apple's Macintosh and its companion MacPaint program, and IBM's PC computer and its companion PC Paint program, include keyboards for input to the computer, a CRT display, and hard and soft disk drives. Such computers can be loaded with and can run any program os a user's choosing. A user can modify such programs. By contrast, a user cannot re-program or otherwise modify the MARIO PAINT firmware cartridge. The SNES console has no keyboard, no disk drives, no CRT, and no capacity to load any program.

C.A. App. 487-89.

[3] Gussin argued that a prior patent — known as the Burson patent — did not render his claims invalid for obviousness because the Burson patent was "not capable of being used to create images as one would paint a picture" *and* because the Burson patent had "joysticks for controlling the position of a cursor, that . . . depends on the particular game cartridge." C.A. App. 170. The District Court took Gussin's argument — that Burson's patent could not be used to draw — out of context to bar claim coverage for *any* video game that uses cartridges.

to be "reprogrammed by the user."[4]

b. Second, the District Court held, in construing Gussin's patent claim, that "the Gussin invention is limited to a device containing a specific 'pixel memory' configuration," while the Nintendo system instead "utilize[s] a two-memory configuration." Pet. App. 18a, 26a.[5] In reaching this conclusion, the court resolved a wealth of disputed factual questions arising from the prosecution history of Gussin's patent. Indeed, the PTO had concluded that "[t]he '335 patent" — like the Nintendo system — "is actually a *two-memory* system. Figure 2 of the '335 patent shows a color memory 44 ('COLOR ROM') *and* a PIXEL MEMORY 46." C.A. App. 301 (emphasis added). Moreover, the court disregarded Gussin's declaration, which explained — using the admissions of Nintendo's experts and the company's own technical documentation — that "[t]he SNES console has a 'pixel memory'

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[4] Mr. Kenji Imai, Nintendo's designee for discovery pursuant to Fed. R. Civ. P. 30(b)(6), testified as follows:

> Q. Is the Super Nintendo Entertainment System a personal computer, in your opinion?
> A. It is not.
> Q. Is the Super Nintendo Entertainment System a general purpose computer, in your opinion?
> A. It is not.
>
> * * *
>
> Q. Is the Mario Paint ROM cartridge intended to be reprogrammed by the user?
> A. No.
> Q. Does the user of the Super Nintendo Entertainment System, when it's loaded with Mario Paint, have to know how to operate a computer to use the system?
> A. No, it's not necessary that he know that.

C.A. App. 1200, 1202-03.

[5] The image on a television screen is formed by an array of dots or picture elements ("pixels" for short). When activated, individual pixels emit light of a particular color and intensity. When all the pixels of a television screen are viewed together, a visible color image appears on the screen.

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as that term is used in claims 1 and 2 of my '335 patent." C.A. App. 489.[6] Nintendo's expert admitted that its device, like Gussin's invention, stores color data in its pixel memory. C.A. App. 490.

c. Third, the District Court inferred that Gussin's claims 1 and 2 were limited to two joysticks rather than the multi-function mouse used by Nintendo. Pet. App. 18a. The District Court assumed that a "joystick" and a "mouse" are necessarily exclusive devices. But the court ignored Gussin's declaration, which asserted that "[t]he word 'joystick,' as used in claim 1, has a meaning broad enough to those skilled in the electronic video art field to include Nintendo's SNES mouse." C.A. App. 491. Gussin submitted several U.S. patents in the electronic video art field that use the term "joystick" to mean "mouse." *E.g.*, C.A. App. 727, 747.

Moreover, claim 2 of Gussin's patent does not refer to "joysticks" at all, but rather to two "movable member[s]" that allow for real-time drawing and color command, based on their position. The District Court nonetheless held that there could be no infringement as a matter of law, on the ground that "the SNES/Mario Paint combination uses a color palette system that does not 'command' colors based on the position of a second moveable member." Pet. App. 29a (quoting Declaration of Nintendo's expert). The court cited no evidence for this finding, other than Nintendo's expert's unsupported assertion. The court ignored the contrary factual analysis in Gussin's declaration, which explained that the two systems were equivalent: in the Nintendo system, color is commanded when a first movable member (the Nintendo trackball) is moved so that the cursor is in the color palette portion of the TV screen, where color choices are displayed, and when the second movable member

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[6] Gussin explained that the Nintendo system, like the '335 patent, has a pixel memory "comprising a Random Access Memory (RAM) having digital memory addresses corresponding to the pixels and adapted to be read in correspondence with the conventional horizontal and vertical scanning of a video monitor." C.A. App. 487.

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(the switch atop Nintendo's mouse) is depressed.[7]

d. Fourth, the District Court concluded that Gussin's claims 1 and 2 pertained only to a "dedicated" draw switch rather than a multi-purpose draw switch such as the one on the Nintendo mouse. Pet. App. 18a. As noted previously, however, the word "dedicated" does not appear in either Gussin's claims or in the patent's file history. And nothing in Gussin's specification or claims requires that the draw switch be "dedicated" — *i.e.*, that it not perform functions in addition to the draw/no draw functions. The District Court disregarded these facts and dismissed the analysis in Gussin's declaration that the Gussin draw switch is no more "dedicated" than Nintendo's: the Nintendo mouse has a two-position switch on the top which, if pushed, causes the trackball on the bottom of the mouse to draw. If the switch is not pushed, the trackball does not draw. If the trackball is moved so that the cursor is positioned at the top of the screen, the switch selects a desired, pre-mixed color. C.A. App. 488, 492, 495. The court also chose to disregard Mr. Brunton's expert opinion on the issue.[8]

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[7] *See* C.A. App. 491 ("As Nintendo's Dr. Ward admits, a user of the SNES/MARIO PAINT hardware/firmware combination selects a cursor color by moving the [track]ball of the mouse over a surface to move the cursor over an icon representing the desired color, then depressing the switch atop the mouse to select that color. . . . The switch atop the mouse, in combination with hardware and firmware in the SNES console and MARIO PAINT cartridge, work together to recognize and execute a user's cursor color selections.").

[8] C.A. App. 806-07 ("Dr. Ward's declaration, which Nintendo paraphrases and repeats in its moving papers, contains other errors of claim interpretation. For example, neither claim 1 nor claim 2 states that the joysticks of claim 1, the movable members of claim 2, and the draw switch of claim 1 or claim 2, must be separate from one another, be operable simultaneously, be single-function, be dedicated function, or exclude a mouse. The PTO did not require Gussin to include such statements in these claims, and Gussin refrained from doing so. Gussin never argued that claim 1 or claim 2 differed from the prior art for any of these reasons. If the PTO thought that claims 1 and 2 should be limited to a 'single function,'

e. Gussin also argued that, even if the Nintendo system did not literally infringe the Gussin patent, the Nintendo system infringed under the so-called "doctrine of equivalents."[9] In rejecting this claim, the District Court resolved additional disputed factual issues and simply disregarded Gussin's declaration explaining in detail the substantial equivalence between the two devices.[10]

'separate' or 'dedicated function' draw switch, joystick or movable member, the PTO would have required Gussin to include the such language in the claims. Dr. Ward's opinion is apparently based on an example of Gussin's system, called an 'illustrative example' in the specification of the '335 patent. None of the details of that example are included in the words of claim 1 or claim 2, and there is no basis in the PTO prosecution history for including those details in claim 1 or claim 2, as Dr. Ward has done. Gussin's specifications include no definitions of the claim terms 'movable members' or 'draw switch,' and Gussin's examples do not define these terms.").

[9] The doctrine of equivalents is founded on the theory that "if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same [for patent infringement purposes], even though they differ in name, form, or shape." *Machine Co. v. Murphy*, 97 U.S. 120, 125 (1877). If "minor variations [could] conceal and shelter the piracy," the protection of the patent law would be "a hollow and useless thing." *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 607 (1950).

[10] Gussin explained:

> *First*, the MARIO PAINT combination is a hardware/firmware device, not a general-purpose, programmable computer, and is dedicated to electronic drawing and painting on the screen of a color TV set to which the combination is attached. The combination does so in the same way as my claimed system, i. e. by delivery of signals from the pixel memory of the combination to the color TV set. The result is the same as with my claimed systems, the production of a user's drawing and painting on the screen of a color TV set to which the combination is attached. Dr. Ward and Nintendo's FRCP Rule 30(b)(6) spokesmen Nishiumi and Imai agree with me on this point.
>
> *Second*, the pixel memory, or VRAM, or the MARIO PAINT

5. *The Federal Circuit's Decision.* On appeal, Gussin argued that "[t]he District Court's wholesale adoption of Nintendo's arguments was contrary to both Gussin's and Gussin's licensees' interpretation of Gussin's claims 1 and 2, and resolved factual disputes in the movant's favor." Gussin Ct. App. Br. 4 (filed Jan. 26, 1995). But the Federal Circuit ruled that summary judgment was proper notwithstanding these factual disputes.

The Federal Circuit asserted, preliminarily, that Gussin's

> combination has substantially the same function as my pixel memory, namely the storage of digital signals representing cursor x,y position and cursor color, and carries out its function in substantially the same way, i. e. by receiving digital signals from two joysticks, two movable members, or their equivalents. . . .
>
> *Third*, the two joysticks of my claim 1 and the two movable members of my claim 2 perform the function of delivering signals representing a user's desired x,y cursor position and desired cursor color to a pixel memory in the system. In the MARIO PAINT combination, a user's manipulation of a switch on the mouse when the cursor is over a desired color in the color palette, and of the ball at the bottom of the mouse, when the cursor is over the draw/paint area, delivers such signals to the VRAM or pixel memory, representing the user's desired cursor color position and desired cursor x,y position. The result is substantially the same, namely the delivery to the VRAM, or pixel memory, of these signals for storage and use by the system.
>
> *Fourth*, the draw switch of my claims 1 and 2 permits a user to move the cursor while creating a trace (the "draw" mode), or to move the cursor without creating a trace (the "no draw" mode). Depressing the switch on the MARIO PAINT combination's mouse when the cursor is moving in the drawing area invokes the "draw" mode. Releasing the switch on the mouse when the cursor is in the drawing area invokes the "no draw" mode. Thus, the draw switch in the MARIO PAINT combination invokes the "draw" mode and "no draw" mode in the same way as my claimed systems, with substantially the same result: drawing or not drawing, at the user's option.

C.A. App. 494-95 (emphasis in original).

"Statement of Genuine Issues of Material Fact" in the District Court was procedurally deficient under the District Court's local rules. Pet. App. 5a. But, like the District Court,[11] the Court of Appeals proceeded to decide the case on the merits. In the key passage in its opinion, the Federal Circuit explained:

> Gussin argues that summary judgment was inappropriate because genuine issues of material fact exist regarding the construction of the asserted claims. In particular, *Gussin asserts that the declarations of his experts, the admissions of Nintendo's experts during depositions, and the prosecution history of the '335 patent create genuine issues of material fact precluding summary judgment.*
>
> This court recently rejected similar arguments concerning claim construction in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 U.S.P.Q.2d (BNA) 1321 (Fed. Cir. 1995) (in banc), in which we held that claim construction is a question of law amenable to summary judgment. *The alleged conflicting opinions of both parties' experts do not create genuine issues of fact precluding summary judgment as to the meaning of the claims at issue. See Markman*, 52 F.3d at 983, 34 U.S.P.Q.2d (BNA) at 1333 ("When 'legal' experts offer their conflicting views of how the patent should be construed, . . . such conflict does not create a question of fact . . . ."). Therefore, we reject Gussin's argument that summary judgment was inappropriate.

Pet. App. 5a-6a (emphases added). The Federal Circuit

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[11] The District Court explained that "the Court will *not* rely solely on [the supposed procedural defect] to support its Order and will evaluate Defendant's motion on its merits." Pet. App. 17a (emphasis added). The District Court could hardly have proceeded otherwise, since it had denied Gussin leave to file an amended Statement of Genuine Issues of Material Fact on the ground that — in the Court's words — "I think it would be a futile act." C.A. App. 1468.

proceeded to undertake its own review of the evidence in the case. The Court of Appeals concluded that the District Court had "properly construed" Gussin's patent claim, *id.* at 6a, and therefore affirmed the grant of summary judgment to Nintendo.

Gussin filed a petition for rehearing, arguing that the court had premised its decision on *Markman*, which was then pending before this Court on certiorari. Gussin suggested that the Federal Circuit hold the petition for rehearing in abeyance until this Court had decided whether to review *Markman*, since "[i]f the U.S. Supreme Court takes the *Markman* case for review, this Court's decision must be modified." Pet. for Rehearing at 8 (filed Aug. 17, 1995). On August 30, 1995, the Court of Appeals denied rehearing. Pet. App. 1a. On Sept. 27, this Court granted certiorari in the *Markman* case.

REASONS FOR GRANTING THE WRIT

1. This case presents the same question on which this Court granted review in *Markman*: "In a patent infringement action for damages, is there a right to a jury trial under the Seventh Amendment of the United States Constitution of genuine factual disputes about the meaning of a patent?" Pet. for Cert., No. 95-26, at i (filed July 3, 1995). Here, the Federal Circuit held that the District Court was entitled to proceed to summary judgment regardless of whether there were "genuine issues of material fact . . . regarding the construction of the asserted [patent] claims," arising from "the declarations of [petitioner's] experts, the admissions of Nintendo's experts during depositions, and the prosecution history of the '335 patent." Pet. App. 5a. According to the Federal Circuit in this case, *Markman* established that "claim construction is a question of law amenable to summary judgment." *Id.* at 6a. Under the Court of Appeals' decision, "[t]he alleged conflicting opinions of both parties' experts do not create genuine issues of fact precluding summary judgment as to the meaning of the claims at issue." *Id.*

The Federal Circuit's reasoning runs squarely afoul of the

Seventh Amendment. Interpreting a patent claim is a factual inquiry, not a legal one. It turns on how a person schooled in the relevant art would have understood a particular term at the time of the invention, not on what the patent means to a judge. That is why factual evidence, such as testimony from those schooled in the art, expert testimony, the history of the prosecution of the patent, and other evidence, is typically introduced in order to determine the meaning of a patent. A factfinder must resolve the issue by considering testimony and documents, weighing conflicting evidence, making credibility determinations, and judging the demeanor of witnesses.

Thus, this Court has long recognized that underlying factual disputes regarding the interpretation of a patent claim are to be resolved by a jury. In *Silsby v. Foote*, 55 U.S. (14 How.) 218 (1852), for example, this Court explained that the meaning of a patent was "a question for the jury, upon the evidence of experts, or an inspection by them of the machines, or upon both, what parts described did in point of fact enter into, and constitute an essential part of this combination." *Id.* at 226. Similarly, in *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453 (1872), this Court remarked that, with respect to the meaning of a patent, "the ultimate response to the question must come from the jury." *Id.* at 455. A noted commentator explained that, "[w]hen the Claim itself refers to facts, the existence and character of which must be determined before the Claim can be construed, evidence concerning these facts may be submitted to the jury, whose finding thereon thus enters into and becomes an element in the interpretation of the Claim." 3 William C. Robinson, THE LAW OF PATENTS FOR USEFUL INVENTIONS § 1037 (1890).

To determine the scope of the jury trial right protected by the Seventh Amendment, "resort must be had to the appropriate rules of the common law established at the time of the adoption of that constitutional provision in 1791." *Dimick v. Schiedt*, 293 U.S. 474, 476 (1935). Under English practice as of 1791, cases involving "letters patent," like those involving other "grants, licenses [or] charters" from the Crown, had been tried to juries

for over a century and a half. *See* Statute of Monopolies, 21 Jac. I, ch. 3, § 2 (1623).

At common law, it was settled that juries, not judges, interpreted the meaning of patents. *See Turner v. Winter*, 1 T.R. 602, 605 (K.B. 1787) (remanding case for interpretation of patent by jury); F. Buller, AN INTRODUCTION TO TRIALS AT NISI PRIUS 76 (6th ed. 1791) (in determining the validity of a patent, juries must also determine "[t]he meaning of the specification"); I J. Oldham, THE MANSFIELD MANUSCRIPTS AND THE GROWTH OF ENGLISH LAW IN THE EIGHTEENTH CENTURY 756 (1992) (reporting that in *Liardet v. Johnson*, decided in 1778, the jury was instructed to determine "all objections made to exactness, certainty and propriety of the specification"). Juries resolved interpretive disputes regarding other grants under the Statute of Monopolies as well.[12]

In *Washburn v. Gould*, 29 Fed. Cas. 312 (C.C.D. Mass. 1844), Justice Story summarized the English practice in patent cases. "[T]he jury are to judge the meaning of words of art, and technical phrases, in commerce and manufactures, and of the surrounding circumstances, which may materially affect, enlarge or control the meaning of the words of the patent and specification." *Id.* at 325.

The Federal Circuit's approach in the instant case would defeat the right to jury trial through the artifice of re-classifying questions of fact as issues of "law." But this Court has made clear that the Seventh Amendment "requires that questions of fact in common law actions shall be settled by a jury, and that the court shall not assume directly or indirectly to take from the jury or to itself such prerogative." *Walker v. New Mexico Railroad Co.*, 165 U.S. 593, 596 (1897).

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[12] *See, e.g., Collins v. Sawrey*, 4 Bro. P.C. 692, 699 (H.L. 1772) (rejecting argument that the "construction" of a charter, because it depended on written evidence, should not have been "tried . . . by a jury"); *Mayor of Kingston Upon Hull v. Horner*, 1 Cowp. 102, 108 (1774) (dispute about the interpretation of a charter "is a question of fact" and "therefore most proper to be left to the decision of the jury").

2. In fact, this case merits review independently of *Markman*, for the District Court in this case went even *further* than *Markman* allowed. Here, the District Court resolved numerous disputed factual questions regarding not only the scope of *Gussin's* patent, but also the nature of *Nintendo's* system. For example, the District Court held that the SNES/Mario Paint combination did not infringe on Gussin's patent because it (a) was a "programmable computer"; (b) utilized a "two-memory configuration" that was distinct from Gussin's system, rather than a "pixel memory"; (c) used a trackball/mouse rather than a "dedicated" joystick; (d) used a color palette system that did not "command" colors "based on the position of a second movable member"; (e) used a draw switch that was not a "dedicated" one; and (f) did not infringe on Gussin's invention under the doctrine of equivalents. Each of these points involved disputed factual questions.

Yet not even *Markman* purported to withdraw such issues from the jury. Indeed, given the long history of jury trials of infringement actions at common law and under 35 U.S.C. § 281, any such withdrawal would plainly violate the Seventh Amendment.[13] Thus, in *Markman* the Federal Circuit stated that it was expressly preserving "[t]he patentee's right to a jury trial *on the application of the properly construed claim to the accused device.*" 52 F.3d at 984 (emphasis added). Here, that right was eviscerated.

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[13] As long ago as 1623, the Statute of Monopolies provided that patent infringement actions "shall be for ever hereafter examined, heard, tried, and determined, by and according to the common laws of this realm, and not otherwise." 21 Jac. I, ch. 3, § 2. According to section 4 of the Patent Act of 1790, anyone who without authority "devise[d], ma[d]e, construct[ed], use[d], employ[ed], or vend[ed]" a patented invention was liable to the patentee for "such damages as shall be assessed by a jury." Patent Act of 1790, § 4, 1 Stat. 111. *See also Bramah v. Hardcastle*, 1 Carpmael Patent Cas. 168 (K.B. 1789); *Morris v. Bransom*, 1 Carpmael Patent Cas. 30 (K.B. 1776); 2 W. Blackstone, COMMENTARIES ON THE LAWS OF ENGLAND 579 (E. Christian 13th ed. 1796); 2 J. Story, COMMENTARIES ON EQUITY JURISPRUDENCE §§ 930-34, at 236-39 (13th ed. 1886).

Accordingly, the same Seventh Amendment principle that compelled the grant of certiorari in *Markman* warrants this Court's review here. If determining disputed facts regarding claim interpretation is the jury's responsibility, it follows *a fortiori* that resolving factual questions surrounding infringement must also be a task left for the jury.

CONCLUSION

The petition for a writ of certiorari should be granted or, at minimum, held pending disposition of *Markman v. Westview Instruments, Inc.*, No. 95-26.

Respectfully submitted.

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November 1, 1995

APPENDIX

Appendix A

UNITED STATES COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

No. 95-1051

EDWARD L. GUSSIN,
Plaintiff-Appellant,

v.

NINTENDO OF AMERICA, INC.,
Defendant-Appellee.

O R D E R

Before RICH, Circuit Judge, LOURIE, Circuit Judge, and BRYSON, Circuit Judge.

A petition for rehearing having been filed by the APPELLANT,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED.

The mandate of the court will issue on September 6, 1995.

FOR THE COURT,
FRANCIS X. GINDHART, CLERK

Dated: August 30, 1995 by /s/
Diane M. Frye
Chief Deputy Clerk

cc: Patrick F. Bright
John J. Kirby, Jr.

Note: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public record.

Appendix B

NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. The disposition will appear in tables published periodically.

UNITED STATES COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

No. 95-1051

EDWARD L. GUSSIN,
Plaintiff-Appellant,

v.

NINTENDO OF AMERICA, INC.,
Defendant-Appellee.

DECIDED: August 3, 1995

Before RICH, LOURIE, and BRYSON, Circuit Judges.

LOURIE, Circuit Judge.

DECISION

Edward L. Gussin appeals from an order of the United States District Court for the Central District of California granting summary judgment that claims 1 and 2 of United States Patent 4,782,335 were not infringed by Nintendo of America, Inc. *Gussin v. Nintendo of Am., Inc.*, 33 U.S.P.Q.2d (BNA) 1418 (C.D. Cal. 1994). Because we agree that Gussin's "Statement of Genuine Issues of Material Fact" was deficient, the court's finding of lack of literal infringement was based on a proper construction of claims 1 and 2, and prosecution history estoppel prevents a finding of infringement under the doctrine of equivalents, we affirm.

DISCUSSION

Gussin was granted U.S. Patent 4,782,335 (the '335 patent) entitled "Video Art Electronic System" on November 1, 1988.[1] The invention is directed to an electronic system for drawing and coloring pictures on a conventional television monitor. A user operates the system using three controls. The first moves a drawing cursor on the screen; the second turns the drawing function on and off; and the third determines the color of the drawing when the drawing function is turned on.

Nintendo sells the "Super Nintendo Entertainment System" (SNES), a home video game system that allows a user of the system to play an assortment of video game cartridges on an ordinary television monitor. One such game cartridge that Nintendo developed is "Mario Paint." Like Gussin's invention, the Mario Paint cartridge and the SNES allow a user to draw and color pictures on a television monitor. In addition, the Mario Paint cartridge allows the user to compose music and animate pictures.

On July 21, 1993, Gussin sued Nintendo for infringement of claims 1 and 2 of the '335 patent. Claims 1 and 2 are independent claims, which read, in relevant part:

1. A video art electronic system for drawing and coloring on a conventional color television video monitor including a television screen having predetermined pixels, comprising:

    a draw switch . . .;

    means including a first joystick to produce first digital signals representing the "X" and "Y" coordinates of a pixel position of a cursor on the video monitors;

    means including a second joystick to produce second digital signals representing the color of the cursor on the

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[1] On November 20, 1992, the U.S. Patent and Trademark Office (PTO) granted a request for reexamination of the '335 patent in view of several prior art references, including U.S. Patent 4,200,867 (the '867 patent) issued to Hill and entitled "System and Method for Painting Images by Synthetic Color Signal Generation and Control." A reexamination certificate issued on September 21, 1993, indicating that claim 1 had been confirmed and claim 2 had been allowed after certain amendments.

video monitor;

a pixel memory comprising a random access memory (RAM) having digital memory addresses corresponding to the pixels and adapted to be read in correspondence with the conventional horizontal and vertical scanning of the video monitor;

first connecting means operative when the draw switch is in its first position to connect said first and second digital signals to said pixel memory *so that the color and position of the cursor on the video monitor are written into said pixel memory*;

means to convert output signals from said pixel memory to conventional color television signals; and

means to convert said first and second digital signals to conventional color television signals . . . .

2. A video art electronics system for drawing and coloring on a conventional color television video monitor including a television screen having predetermined pixels, said system comprising a first and second member positionably movable by an operator . . . said system further comprising:

a draw switch having a first position for invoking said first mode of drawing and coloring on the video monitor and a second position for invoking said second mode of not drawing and coloring on the video monitor;

a pixel memory comprising a random access memory and means operative in said first mode to store the commanded color of the cursor in said pixel memory . . . [emphasis added].

The court granted summary judgment in favor of Nintendo because Gussin's "Statement of Genuine Issues of Material Fact" was procedurally deficient and violated the court's local rules. In particular, the court found that Gussin "fail[ed] to specifically identify, in an intelligible manner, [the] facts asserted to be disputed and specific evidence in support of those assertions." *Gussin*, 33 U.S.P.Q.2d (BNA) at 1420. The court further held that Nintendo's accused device was not encompassed by claims 1 and 2 because it did not include, *inter alia*, a pixel memory that stored actual color data as required by the claims. The court also granted summary

judgment that Nintendo did not infringe under the doctrine of equivalents because "Gussin simply may not claim equivalency with subject matter he specifically relinquished during prosecution." *Id.* at 1428. Gussin now appeals.

A court must grant summary judgment when there is no genuine issue as to any material fact and the moving party is entitled to a judgment as a matter of law. Fed. R. Civ. P. 56(c). If a party fails to make a showing sufficient to establish the existence of an element essential to that party's case, summary judgment is appropriate. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). We review the district court's grant of summary judgment *de novo*.

We agree with the district court that summary judgment was appropriate because Gussin's "Statement of Genuine Issues of Material Fact" was deficient. Gussin simply asked nine vague questions that do not set forth evidence that raises a disputed issue of material fact. Moreover, as we analyze below, we agree with the court's alternate conclusion that summary judgment was appropriate because the Nintendo device does not infringe, either literally or under the doctrine of equivalents.

1. *Literal Infringement*

A literal infringement analysis requires two separate steps. First, the claims asserted to be infringed must be construed to determine their meaning and scope. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976, 34 U.S.P.Q.2d (BNA) 1321, 1326 (Fed. Cir. 1995) (in banc). Second, the claims as construed are compared to the allegedly infringing device. *Id.* To infringe, the accused device must contain every limitation of the asserted claim. *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1535, 19 U.S.P.Q.2d (BNA) 1367, 1369 (Fed. Cir. 1991).

On appeal, Gussin argues that summary judgment was inappropriate because genuine issues of material fact exist regarding the construction of the asserted claims. In particular, Gussin asserts that the declarations of his experts, the admissions of Nintendo's experts during depositions, and the prosecution history of the '335 patent create genuine issues of material fact precluding summary judgment.

This court recently rejected similar arguments concerning claim

construction in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 U.S.P.Q.2d (BNA) 1321 (Fed. Cir. 1995) (in banc), in which we held that claim construction is a question of law amenable to summary judgment. The alleged conflicting opinions of both parties' experts do not create genuine issues of fact precluding summary judgment as to the meaning of the claims at issue. *See Markman*, 52 F.3d at 983, 34 U.S.P.Q.2d (BNA) at 1333 ("When 'legal' experts offer their conflicting views of how the patent should be construed, . . . such conflict does not create a question of fact . . . ."). Therefore, we reject Gussin's argument that summary judgment was inappropriate.

Gussin further argues that the court improperly construed the "pixel memory" limitation of claims 1 and 2. We disagree. The court properly construed the claims, based on the specification and prosecution history, to require a pixel memory that stores actual color data, instead of one that stores "pointers"[2] to a memory separate from the pixel memory.

Both claims 1 and 2 state that the "color data" to be stored in the pixel memory should be the "color of the cursor." Specifically, claim 1 requires a "pixel memory comprising a random access memory (RAM)" into which "the color and position of the cursor on the video monitor are written." Col. 9, 11. 49-58. Claim 2, as amended after reexamination, requires "a pixel memory comprising a random access memory, and means operative in said first mode to store the commanded color of the cursor in said pixel memory." Reexamination Certificate B1 4,782,355, col. 2, 11. 23-25. Thus, both claims require storage of the color of the cursor in the pixel memory rather than permitting the pixel memory to store pointers to color data stored in a separate color memory.

The specification and the prosecution history further make clear that the claims, as properly construed, only read on devices that store actual color data in the pixel memory. The patent specification describes the "color data" of the present invention as consisting of "a single six bit data word in which two bits represent the intensity of the color red, two bits represent the intensity of the

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[2] A "pointer" is "[a] data item that specifies the location of another item." THE NEW IEEE STANDARD DICTIONARY OF ELECTRICAL AND ELECTRONICS TERMS 964 (5th ed. 1993).

color blue and two bits represent the intensity of the color green." Col. 5, 11. 64-68, and col. 6, 11. 1-3. As Figure 2 of the patent illustrates, Gussin discloses the use of two memories for storing the color data: a color ROM and a pixel memory. The specification describes the interaction of these two memories:

> Information as to a picture to be displayed on video monitor 20 is represented electronically by data words stored in the pixel memory 46 at addresses corresponding to the address of the pixels of the video monitor 20. . . . The position of the joystick 24 determines a six bit color data word from the color ROM 44 which is enabled onto data lines coupled into the pixel memory 46 . . . . The six bit color data word from the color ROM 44 is recorded at the address [in the pixel memory] corresponding to the coordinates of the pixel on the video monitor 20 at which the cursor 18 is located.

Col. 6, 11. 16-36. The specification consistently refers to the data that are transferred from the color ROM and stored in the pixel memory as consisting of actual "color data," not a pointer to a separate memory containing the actual color data.

The prosecution history further supports a claim construction requiring the storage of actual color data in the pixel memory. During reexamination of the patent, Gussin distinguished his claimed invention from the '867 patent issued to Hill. The '867 patent discloses a home entertainment system that, like the invention disclosed in Gussin's '335 patent, allows a user to draw and paint color images on a conventional television monitor. In its "Office Action in Reexamination," the PTO rejected claim 2 under 35 U.S.C. § 102(b) as being anticipated by the '867 patent. The PTO further rejected claim 1 under 35 U.S.C. § 103 as being unpatentable over the '867 patent in view of other prior art.

Gussin filed a "Response to Office Action in Reexamination," in which he distinguished his claims from the '867 patent. Gussin argued:

> The PTO also fails to understand important differences between the function of the pixel memory in claim 1 of the '335 patent and the pixel memory in Mr. Hill's color palette systems. In Gussin's claim 1, the pixel memory receives and stores digital signals representing the actual color of the

> cursor. In Mr. Hill's color palette systems, the pixel memory does not receive or store a signal representing the *actual color* of the cursor. Instead, Mr. Hill's pixel memory receives, and stores a color pointer, namely a signal representing the address of a color in the separate color memory of Hill's color palette systems [emphasis added].

In support, Gussin filed the declaration of Hill, the named inventor of the '867 patent, which stated:

> The devices described in the '335 patent, claims 1 and 2, *directly store in a pixel memory the digital value corresponding to the color* that the operator has commanded to produce on the screen of a color TV receiver or monitor. The devices described in my '867 patent require an additional color memory to store the digital representation of the color values that the operator creates by mixing together various proportions of the primary colors or by adjusting the hue, saturation and brightness of the signals [emphasis added].

Gussin also submitted a declaration in which he argued that claims 1 and 2 were patentable over the '867 patent because "the products described in my '335 patent do not include color memory or color mixing means as described in the '867 patent . . . ."

Gussin asserts that these arguments were limited to distinguishing Gussin's claims from the '867 patent based on the use of a separate memory that stores "user-mixed" colors. Gussin therefore argues that the pixel memory limitation should be broadly construed to cover any pixel memory system that stores "pre-mixed" colors. We disagree that Gussin's arguments during reexamination were so limited.

While it is true that Gussin distinguished the claimed invention from Hill during prosecution based on the storage of "user-mixed" colors instead of "pre-mixed" colors, Gussin also distinguished the claims from the '867 patent based on the way the pixel memory operates. He consistently argued before the PTO that his invention was distinguishable from the '867 patent because he did not claim a pixel memory that stores a color pointer instead of actual color data. In fact, the examiner specifically noted this distinction

when he allowed claim 1:[3]

> None of the references . . . teach a "random access memory" wherein the "*color* and position of the cursor on the video monitor are written into said *pixel memory*", lines 16 and 24-25 of claim 1. Hill does not store color data into the pixel memory, rather he uses the pixel memory to address a second memory which acts as a color palette [emphasis in original].

Gussin argues that the examiner's statement in the March 10, 1993 "Office Action in Reexamination" that the "'335 patent is actually a two-memory system" is inconsistent with our claim construction. To the contrary, the examiner's complete statement adds support to our claim construction:

> The '335 patent is actually a two-memory system. Figure 2 of the '335 patent shows a color memory 44 ("COLOR ROM") and a "PIXEL MEMORY" 46. Memory 46 of the '335 patent is similar to memory 164 of the '867 patent and memory 44 of the '335 patent is similar to memory 166 of the '867 patent, i.e. one is a pixel memory and the other is a color memory. How these two memories interact is different. In the '867 patent the pixel memory reads data out to the address port of the color memory. The '335 patent reads color data into the pixel memory to be stored. *Therefore the '867 patent does not store color cursor data in it's [sic] pixel memory* [emphasis in original].

The examiner, accepting Gussin's argument in his "Response to Office Action in Reexamination," merely emphasized the difference between how the pixel memory in each system interacts with the rest of its respective system - the key distinction being that "the

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[3] During reexamination, Gussin added the pixel memory limitation to claim 2. The examiner allowed the claim following Gussin's amendment. We construe the pixel memory limitation in both claims 1 and 2 identically. It is clear from Gussin's "Response to Office Action in Reexamination" and the examiner's "Notice of Intent to Issue Reexamination Certificate" that both Gussin and the examiner construed the pixel memory limitation similarly for both claims 1 and 2.

'867 patent does not store color cursor data in it's [sic] pixel memory." Based on the foregoing, we conclude that claims 1 and 2, as properly construed, require that the pixel memory store actual color data, not merely pointers to color data stored in a separate memory.

Finally, Gussin argues that even if the claims require that the pixel memory store actual color data, genuine issues of material fact exist as to whether Nintendo's SNES device meets this limitation. In support, Gussin claims that Nintendo's expert witnesses admitted in their declarations and during depositions that the SNES stores actual color data. However, the declarations indicate instead that the pixel memory in the SNES device stores pointers rather than actual color data, and the deposition testimony relied upon by Gussin is not inconsistent with these declarations. Thus, Gussin has failed to establish the existence of any genuine issue of material fact regarding the operation of the pixel memory of the SNES device.

We need not address Gussin's other asserted errors in the district court's claim construction and infringement analysis. Our determination that Nintendo's SNES device does not meet the pixel memory limitation as properly construed is sufficient to cause us to affirm the trial court's grant of summary judgment that Nintendo's device does not literally infringe. *See Lantech, Inc. v. Keip Mach. Co.*, 32 F.3d 542, 547, 31 U.S.P.Q.2d (BNA) 1666, 1671 (Fed. Cir. 1994) ("For literal infringement, each limitation of the claim must be met by the accused device exactly, any deviation from the claim precluding a finding of infringement.").

2. *Doctrine of Equivalents*

An accused product that does not literally infringe may still infringe under the doctrine of equivalents. However, the doctrine of prosecution history estoppel limits the application of the doctrine of equivalents by preventing a patentee from using the doctrine to recapture subject matter previously surrendered in order to procure issuance of the patent. *Southwall Technologies Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1579, 34 U.S.P.Q.2d (BNA) 1673, 1679 (Fed. Cir. 1995). As discussed above, Gussin expressly distinguished his invention from the '867 patent during prosecution of the '335 patent based on two arguments: 1) his invention uses pre-mixed colors, not

user-mixed colors; and 2) his invention stores actual color data in its pixel memory, not pointers. As indicated in his reasons for allowance, the examiner allowed the claims based on these distinctions. Therefore, prosecution history estoppel prevents a finding of infringement under the doctrine of equivalents against any device, including Nintendo's SNES device, that uses a pixel memory which stores pointers instead of actual color data. The court's grant of summary judgment of noninfringement under the doctrine of equivalents was proper.

Appendix C

EDWARD L. GUSSIN,
Plaintiff,

v.

NINTENDO OF AMERICA, INC.,
Defendant.

CV 93-4308 LGB (Bx)

UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA

33 U.S.P.Q.2d (BNA) 1418

October 6, 1994, FILED; October 12, 1994, ENTERED

COUNSEL: For EDWARD L GUSSIN, an individual, plaintiff: Patrick F. Bright, Frederick A. Lorig, Bright & Lorig P.C., Los Angeles, CA.

For NINTENDO OF AMERICA, INC., a Washington State corp., defendant: Christopher Norgaard, Mudge Rose Guthrie Alexander & Ferdon, Los Angeles, CA. John J. Kirby, PRO HAC VICE, Terrence J. Connolly, Mudge Rose Guthrie Alexander & Ferdon, New York, NY.

For NINTENDO OF AMERICA, INC., counter-claimant: Christopher Norgaard, Mudge Rose Guthrie Alexander & Ferdon, Los Angeles, CA. John J. Kirby, PRO HAC VICE, Terrence J. Connolly, Mudge Rose Guthrie Alexander & Ferdon, New York, NY.

For EDWARD L GUSSIN, counter-defendant: Patrick F. Bright, Frederick A. Lorig, Bright & Lorig P.C., Los Angeles, CA.

LOURDES G. BAIRD, United States District Judge

OPINION: ORDER GRANTING SUMMARY JUDGMENT

I. INTRODUCTION

Defendant's motion for summary judgment of noninfringement came on regularly for hearing before this Court on September 26, 1994. After reviewing the materials submitted by the parties and considering argument of counsel as well as all other matters presented to the Court, it is hereby ORDERED that Defendant's motion is GRANTED.

II. FACTUAL AND PROCEDURAL BACKGROUND

Edward L. Gussin is the patentee and owner of U.S. Patent no. 4,782,335, which was issued on November 1, 1988 ('335 Patent) and issued upon reexamination on September 21, 1993 (B1 '335 Patent). This patent describes the protected invention as "[a] video art electronic system for drawing and coloring on a conventional color television video monitor [that] includes a first joystick for drawing and a second joystick for coloring. The operation is in real time and is simple enough for a child to use." ('335 Patent, Abstract.) The '335 Patent consists of sixteen claims, three of which (1, 2, and 14) are independent.

Nintendo of America, Inc. manufactures the Super Nintendo Entertainment System (SNES), which is described as a multipurpose, programmable video game system. (Def.'s Mem. Supp. Summ. J. at 1.) Nintendo also manufactures "Mario Paint," a home video game program for use with the SNES. (Id.) The SNES/Mario Paint combination, inter alia, "permits a user to compose music and animate pictures . . . as well as to draw and manipulate complex images with a single, multifunction 'mouse' control." (Id. at 3.) The Mario paint game is in the form of a cartridge that is inserted into the console of the SNES. (See Ward Decl. ¶¶ 18-19.)

In the instant action, Gussin contends that the SNES, when used in conjunction with Mario Paint, infringes on the '335 Patent. For the present purposes only, Nintendo assumes the '335 Patent is valid over prior art. (Def.'s Mem. Supp. Summ. J. at 2 n.2.)

Gussin filed his complaint for infringement on July 21, 1993. Nintendo answered and counterclaimed on September 1, 1993. This Court has jurisdiction over these claims pursuant to 28 U.S.C. § 1338(a).

Nintendo brings the instant motion for summary judgment on the basis of noninfringement alone.[1]

III. SUMMARY JUDGMENT STANDARD

A. IN GENERAL

It is the burden of the party who moves for summary judgment to establish that there is "no genuine issue of material fact, and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c); *British Airways Bd. v. Boeing Co.*, 585 F.2d 946, 951 (9th Cir. 1978), *cert. denied*, 440 U.S. 981 (1979). If the moving party has the burden of proof at trial (the plaintiff on a claim for relief, or the defendant on an affirmative defense), the moving party must make a showing sufficient for the court to hold that no reasonable trier of fact could find other than for the moving party. *Calderone v. United States*, 799 F.2d 254, 259 (6th Cir. 1986) (quoting W. Schwarzer, *Summary Judgment Under the Federal Rules: Defining Genuine Issues of Material Fact*, 99 F.R.D. 465, 487-88 (1984)). Furthermore, if the moving party has the burden of proof at trial, that party must establish peradventure all of the essential elements of the claim or defense to warrant judgment in that party's favor. *Fontenot v. Upjohn Co.*, 780 F.2d 1190, 1194 (5th Cir. 1986).

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[1] Nintendo addresses only claims 1 and 2 of the '335 Patent since claims 3-13 and 15-16 are dependent claims, and since independent claim 14 is narrower than claims 1 and 2. Any claim limitations that apply to claims 1 or 2 will also apply to any dependent or narrower claims. *See London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1539 (Fed. Cir. 1991); 37 C.F.R. § 1.75(c).

If the opponent has the burden of proof at trial, then the moving party has no burden to negate the opponent's claim. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1985). In other words, the moving party does not have the burden to produce any evidence showing the absence of a genuine issue of material fact. *Id.* at 325. "Instead, . . . the burden on the moving party may be discharged by 'showing' — that is, pointing out to the district court — that there is an absence of evidence to support the nonmoving party's case." *Id.*

Once the moving party satisfies this initial burden, "an adverse party may not rest upon the mere allegations or denials of the adverse party's pleadings . . . . The adverse party's response . . . must set forth specific facts showing that there is a genuine issue for trial." Fed. R. Civ. P. 56(e) (emphasis added). A genuine issue of material fact exists only when the nonmoving party makes a sufficient showing to establish an essential element to that party's case, and on which that party would bear the burden of proof at trial. *Celotex*, 477 U.S. at 322-23. "The mere existence of a scintilla of evidence in support of the plaintiff's position will be insufficient; there must be evidence on which a reasonable jury could reasonably find for plaintiff." *Anderson v. Liberty Lobby*, 477 U.S. 242, 252 (1986). The evidence of the nonmovant is to be believed, and all justifiable inferences are to be drawn in its favor. *Id.* at 248.

B. IN PATENT LITIGATION

Although older cases may suggest or even state the contrary, recent decisions of the federal circuit have "repeatedly emphasized that summary judgment is as appropriate in a patent case as in any other." *Avia Group Int'l, Inc. v. L.A. Gear California*, 853 F.2d 1557, 1561 (Fed. Cir. 1988) (internal quotation marks omitted). And, as with any other case, summary judgment is appropriate in patent litigation when there is no genuine dispute as to any material fact. *Id.*; *Winner Int'l Corp. v. Wolo Mfg. Corp.*, 905 F.2d 375, 376 (Fed. Cir. 1990). "Thus, the motion of an accused infringer for judgment on the ground of non-infringement of a patent may be granted where the patentee's proof is deficient in meeting an essential part of the legal standard for infringement." *Johnston v.*

IVAC Corp., 885 F.2d 1574, 1577 (Fed. Cir. 1989).

IV. ANALYSIS

A. PROCEDURAL DEFICIENCIES IN PLAINTIFF'S PAPERS

As an initial consideration, the procedural deficiencies in Plaintiff's papers alone warrant granting summary judgment for Defendant. The moving Defendant has complied with Local Rule 7.14.1 by filing a Statement of Uncontroverted Facts and Conclusions of Law, which contains citations to the evidence upon which it relies. Plaintiff's Statement of Genuine Issues of Material Fact, however, falls far short of what is contemplated by the rules.

First, Plaintiff's Statement of Genuine Issues does not set forth specific facts that are claimed to be disputed. Rather, Plaintiff offers up nine vague interrogatories, several of which are repetitive.[2] The Federal Rules require the party against whom the motion is made to "set forth the specific facts showing that there is a genuine issue for trial." Fed. R. Civ. P. 56(e) (emphasis added); *see also* Local Rule 7.14.2.

More importantly, Plaintiff's statement sets forth no evidence tending to show a factual dispute; in fact there is not a single citation to evidentiary matter in Plaintiff's statement as is required by the local rules. *See id.*; *Nilsson, Robbins, Dalgarn, Berliner, Carson & Wurst v. Louisiana Hydrolec*, 854 F.2d 1538, 1545 (9th Cir. 1988). The purpose of the statement of genuine issues is to educate, not interrogate, the Court.

When an opposing party fails to make a sufficient evidentiary

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[2] For example, plaintiff queries:

> Shouldn't the jury as the trier of fact decide whether Dr. Ward [Nintendo's consultant] should be given any credibility since he admits he has been paid over $ 380,000 by Nintendo over the past five years, and presently earns at least $ 8,000 per month from Nintendo, whether he does any work or not?

(Pl.'s Statement of Genuine Issues ¶ 7.)

showing, a properly supported motion for summary judgment should be granted. *Id.* Even if opposition papers are filed, failure to comply with the local rule requirements governing the filing of a separate statement of disputed facts may be a sufficient basis for granting the motion. *Id.* (affirming summary judgment for, inter alia, nonmovant's failure to comply with "a pertinent local rule expressly indicating that [nonmovants] had an affirmative burden to list genuine issues with appropriate record citations in order to withstand the motion"); *see also* Local Rules 7.9, 7.14.3. Additionally, the genuine issues and supporting evidence must be identified without the assistance of the district judge. *Nilsson*, 854 F.2d at 1545.

Ordinarily, this Court would not favor granting summary judgment on a mere technicality; in this case, however, the shortcomings appear to be caused by a lack of evidence in support of Plaintiff's complaint. The Court is neither required nor inclined to comb the voluminous material submitted by the parties in search of such evidence.

In light of these circumstances, the Court ORDERS that summary judgment be GRANTED in favor of Defendant for Plaintiff's failure to specifically identify, in an intelligible manner, those facts asserted to be disputed and specific evidence in support of those assertions. For the benefit of the parties, the Court will not rely solely on this ground to support its Order and will evaluate Defendant's motion on its merits as follows.

B. INFRINGEMENT ANALYSIS

The law is well established that determining whether patent claims have been infringed requires a two-step analysis. *Carroll Touch, Inc. v. Electro Mechanical Sys., Inc.*, 15 F.3d 1573, 1576 (Fed. Cir. 1993). In the first step, the patent claims are construed to determine their scope and meaning; this step is a question of law for the court. *Id.* at 1576-77. In the second step, the patent claims, as properly construed, are compared to the accused device or process. *Id.* at 1576. "A claim covers [or 'reads on'] an accused device if the device embodies every limitation of the claim, either literally or by an equivalent." *Id.* (emphasis added); *see also Johnston*, 885 F.2d at 1577 & n.3 (discussing this "All Elements

Rule"); *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1259 (Fed. Cir. 1989) (same). The burden is on the patent owner to prove infringement by a preponderance of the evidence. *Carroll Touch*, 15 F.3d at 1578.

1. LITERAL INFRINGEMENT

Nintendo contends that the '335 Patent, properly construed in light of the literal claim and specification language and the prosecution history, contains four essential limitations that are not present in the accused device; to wit, (1) Gussin's patent is limited to a "dedicated hardware device," whereas the accused device is a "programmable computer" that is dependent upon software; (2) the Gussin invention is limited to a device containing a specific "pixel memory" configuration, which is not present in Nintendo's combination; (3) the Gussin device is limited to "two dedicated" joysticks, whereas the accused combination uses a computer mouse; and (4) Gussin's invention requires a "dedicated draw switch," which is also absent from Nintendo's product. Under the All Elements Rule, *supra*, the absence of any one of these limitations in the accused device is a sufficient basis for granting summary judgment based on noninfringement.

Nintendo claims that these limitations and distinctions are clear from the literal claim language and were made by Gussin in order to survive examination and reexamination. Nintendo asserts that, in order to show infringement, Gussin must both interpret his claims in a manner inconsistent with the literal language of the patent and rely on subject matter relinquished during initial prosecution and reexamination. The Court agrees.

It is clear that "a patentee should not be able to obtain, through litigation, coverage of subject matter relinquished during prosecution." *Haynes Int'l, Inc. v. Jessop Steel Co.*, 8 F.3d 1573, 1577 (Fed. Cir. 1993). "The legal standard for determining what subject matter was relinquished is an objective one, measured from the vantage point of what a competitor was reasonably entitled to conclude, from the prosecution history, that the applicant gave up to procure issuance of the patent." *Id.* at 1578. Additionally, "an inventor may not be heard to proffer an interpretation that would alter the undisputed public record (claim, specification, prosecution

history) and treat the claim as a 'nose of wax.'" *Senmed, Inc. v. Richard-Allan Medical Indus., Inc.*, 888 F.2d 815, 819 n.8 (Fed. Cir. 1989) (quoting *White v. Dunbar*, 119 U.S. 47, 51-52 (1886)).[3]

a. DEDICATED HARDWARE

Nintendo first asserts that the '335 Patent is limited to coverage of a "dedicated hardware" system; that is, a "single use" system that does nothing other than create video art. (Def.'s Mem. Supp. Summ. J. at 4, 14.) In contrast, argues Nintendo, the accused system is a programmable multi-use computer system that allows for the use of many different game cartridges, such as Mario Paint, and therefore is not covered by the patent-in-suit.

In the specification of the '335 Patent, Gussin distinguished his invention from the prior art. (See '335 Patent, col. 1, lines 16-61.) He stated that the prior art disclosed "two general groups of electronic systems for drawing on a video monitor." (Id. at 16-18.) In the first group, "a video monitor . . . is used with a computer such as a personal computer and computer software." (Id. at 18-21.) The second group of such systems "requires a computer such as a personal computer, computer software, and a special video monitor responsive to an external stimuli." (Id. at 37-39.)

Nintendo contends that the SNES system is a computer system

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[3] The analysis of prosecution history

> essentially applies to both literal infringement and infringement under the doctrine of equivalents. For purposes of literal infringement, the prosecution history is used to interpret the claims in a manner consistent with [the patentee's] representations during prosecution. In the context of the doctrine of equivalents, the prosecution history acts as formal estoppel to prevent the patent owner from obtaining a scope of equivalency that would resurrect subject matter surrendered during prosecution.

Advanced Cardiovascular Sys. Inc. v. C.R. Bard Inc., 26 U.S.P.Q.2d 1304, 1307 n.5 (N.D. Cal. 1992); *see also Johnston*, 885 F.2d at 1579; *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1270 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 1030 (1987).

and was thus specifically distinguished from Gussin's invention. In deposition, Kenji Imai, Nintendo's Rule 30(b)(6) designee, testified that the SNES "is a computer [and] depending on the kind of software you use with it, the operations can be simple . . . or complex." (Norgaard Decl., Ex. A at 4.) Additionally, Nintendo's consultant Stephen A. Ward testified in deposition that the SNES "is a computer system that is, as I said, specialized by playing games." (Id., Ex. B at 49.)

In response, Plaintiff argues that "Nintendo's 'expert' Dr. Ward admitted that the MARIO PAINT combination is a 'low-end' hardware/firmware device, i.e. a console/cartridge device, and not a computer as did Nintendo's spokesman Imai." (Pl.'s Opp'n Mtn. Summ. J. at 11 (citations omitted).) In light of the deposition testimony cited immediately *supra*, Plaintiff's contention that Dr. Ward and Mr. Imai "admitted" the SNES is not a computer is simply not accurate. Plaintiff also cites deposition testimony in which Ward and Imai state that aspects of the Mario Paint cartridge could be considered "firmware," but Plaintiff does not offer sufficient evidence to controvert Defendant's assertion that the SNES is a computer. Upon consideration of the entirety of the evidence proffered by the parties, the Court concludes that there is no genuine underlying issue of material fact as to this matter. *See Johnston*, 885 F.2d at 1579.

Nintendo also contends that the prosecution history shows that Gussin limited his claims to a dedicated, single-purpose device after his patent application was rejected based on the inventions taught in prior patents.

By Examiner's Action mailed June 10, 1987, the Patent and Trademark Office (PTO) rejected Gussin's patent application[4] for claims 1 through 16 "as being unpatentable over Burson[5] in view of Tsunehiro et al."[6] (Sender Decl., Ex. 3 at 58.) Therein, Gussin responded to this rejection with an application Amendment, received December 2, 1987. (*Id.*, Ex. 5 at 89.) Gussin distinguished Burson

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[4] Serial no. 925,653.

[5] U.S. Patent no. 4,180,805, issued December 25, 1979.

[6] U.S. Patent no. 4,642,625, issued February 10, 1987.

by stating that "whereas Burson appears to have joysticks for controlling the position and color of a cursor, that effect depends on the particular game cartridge used." (*Id.* at 92.) Gussin also wrote that "the effect of movement of [the] joystick . . . depends on the cartridge inserted into the main module." (*Id.*) Thus, the Court finds as a matter of law that Gussin, in order to achieve patentability, specifically limited his invention to single-use hardware by distinguishing Burson, which was a multi-use system in which the effect of its joysticks depended upon the cartridge used.

The SNES/Mario Paint combination is analogous to Burson in that it consists of a main programmable console and a software cartridge. (*See* Ward Decl. ¶¶ 18, 19 ("Mario Paint is only one of hundreds of cartridges that can be used with SNES."); Norgaard Decl., Ex. A at 4, Ex. B at 49.)

In response, Gussin states that "Dr. Ward admitted that Gussin's patent attorneys never amended Gussin's claims 1 and 2 to exclude console/cartridge systems," (Pl.'s Opp'n Mtn. Summ. J. at 11), and "that the PTO never rejected claim 2 for any reason," (*id.*).

Gussin's argument is unavailing. First, by disavowing cartridge-based systems as taught in Burson following rejection of his initial patent application, Gussin excluded video art systems consisting of a console and multiple cartridges from coverage by the '335 Patent. "The prosecution history . . . limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance." *Jonsson v. Stanley Works*, 903 F.2d 812, 817 (Fed. Cir. 1990). Second, the fact that Gussin never amended his claims to specifically exclude cartridge-based systems is of no moment since "for the purposes of literal infringement, the prosecution history is used to interpret the claims in a manner consistent with [the inventor's] representations during prosecution." *Advanced Cardiovascular Sys. Inc. v. C.R. Bard Inc.*, 26 U.S.P.Q.2d 1304, 1307 n.5 (N.D. Cal. 1992); *see also Texas Instruments v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1174-75 ("Amendment of a claim in light of a prior art reference, however, is not the sine qua non . . . .").

In conclusion as to the dedicated hardware limitations, the accused device does not infringe on the '335 Patent since the

SNES/Mario Paint combination is both a multi-use, cartridge-based system and a computer as contrasted to the single-use, dedicated system invented by Gussin. Plaintiff's arguments to the contrary are contradicted by the plain language of the patent specification or by the prosecution history of the patent. Viewed objectively from the vantage point of a what a competitor would reasonably believe, Gussin limited his claims as described above and should not now be able to obtain protection for relinquished subject matter. *Haynes*, 8 F.3d at 1577-78.

Gussin's self-serving and conclusory declarations to the contrary do not raise genuine issues of fact[7] sufficient to avert summary judgment. *Johnston*, 885 F.2d at 1580 ("Conflicting opinions on the meaning of a term which are merely conclusory do not create [sufficient] evidentiary conflict."); *Senmed*, 888 F.2d at 819 n.8 (where words are given their ordinary meaning in the specification and prosecution history, the inventor's "self-serving, post hoc opinion testimony" is of little if any significance).

At the hearing on this motion, Plaintiff's counsel insisted that the Court was engaging in fact finding, which is clearly improper on summary judgment, by "swallowing" the Ward declaration and ignoring the declarations proffered by Plaintiff. The Court disagrees. Rather, the Court has determined that the Gussin and Brunton declarations do not raise genuine issues of fact since they are wholly conclusory and contrary to the prosecution history, which the Court must rely on to interpret the patent-in-suit. As the Johnston court stated, "'general assertions of fact issues, general denials, and conclusory statements are insufficient to shoulder the non-movant's burden.'" 885 F.2d at 1578 (quoting *Chemical Eng'g v. Essef Indus., Inc.*, 795 F.2d 1565, 1571 (Fed. Cir. 1986)). Additionally, and based on the same reasoning, the Court rejects the argument that the Gussin declaration was discounted simply because it was made by the inventor and patentee.

The Court finds that claims 1 and 2 of the '335 Patent, properly

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[7] "To create a genuine issue of fact, the nonmovant must do more than present some evidence on an issue it asserts to be disputed." *Avia Group*, 853 F.2d at 1560. "Instead, the nonmovant's evidence must present a question of material fact, which requires submission to a jury." *Jonsson*, 903 F.2d at 816 (emphasis added).

construed based on the literal claim and specification language as well as prosecution history, do not read on the accused device for the separate reasons described above. Thus, Nintendo's motion for summary judgment of noninfringement must be GRANTED on this second separate ground.

b. PIXEL MEMORY

Nintendo also contends that "Gussin limited his invention to a device containing a 'pixel memory' that stores actual color data for each element of the image displayed on the television screen." (Def.'s Mem. Supp. Summ. J. at 4.) Nintendo argues that the accused combination does not infringe since it does not utilize a similar pixel memory configuration.

The Gussin invention teaches a pixel[8] memory system, in which "information as to a picture to be displayed on [the] video monitor . . . is represented electronically by data words stored in the pixel memory . . . at addresses corresponding to the address of the pixels of the video monitor." ('335 Patent, col. 6, lines 16-20.) Thus, the '335 Patent's pixel memory storage locations store actual color data for each corresponding pixel of an image. (Id., lines 12-36.)

The literal language of claims 1[9] and 2[10] of the '335 Patent

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[8] The image on a television screen is formed by an array of dots or picture elements ("pixels" for short). When activated, individual pixels emit visible light of a particular color and intensity. When all the pixels of a television screen are viewed together, a visible color image appears on the screen. (Ward Decl. ¶ 11.)

[9] In pertinent part, claim 1 requires:

> A video art electronic system for drawing and coloring on a conventional color television video monitor . . . comprising: . . . . a pixel memory comprising a random access memory (RAM) having digital memory addresses corresponding to the pixels and adapted to be read in correspondence with the conventional horizontal and vertical scanning of the video monitor; first connecting means operative when the draw switch is in its first position to connect said first and second digital signals to said pixel memory so that the color and position of the cursor on the video monitor are written into

requires that the invention use a pixel memory. ('335 Patent, col. 9, lines 49-58; B1 '335 Patent, col. 2, lines 23-35.)

Additionally, the prosecution history discloses that Gussin distinguished his invention over the prior art on the basis of the pixel memory. In the Amendment filed by Gussin after rejection of his initial patent application, described *supra*, he further distinguished Burson by stating that "all of [my] claims now pending in the application include . . . a pixel memory . . . for retaining the image drawn that can be scanned so as to produce modulation signals in a television set. Such structure is not found in the cited art." (Sender Decl., Ex. 5 at 93.)

Moreover, Gussin further narrowed his claims as a result of a reexamination proceeding prompted by discovery of additional relevant prior art. In the PTO's Order Granting Request for Reexamination, mailed November 20, 1992, the examiner indicated that reexamination of the '335 Patent had been granted on the basis of anticipation and obviousness by the prior art of Hill,[11] and others. (Sender Decl., Ex. 8 at 102-03.) In his Patentee's Response to

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said pixel memory . . . .

('335 Patent, col. 9, lines 34-37, 49-58 (emphasis added).)

[10] Claim 2, as amended after reexamination, requires:

> A video art electronics system for drawing and coloring on a conventional color television video monitor . . . .
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> . . . .
>
> said system further comprising:
>
> . . . .
>
> a pixel memory comprising a random access memory, and means operative in said first mode to store the commanded color of the cursor in said pixel memory . . . .

(Patent B1 4,782,335, issued on reexamination September 21, 1993, col. 1, lines 20-22, col. 2, lines 17, 23-25 (emphasis altered).)

[11] United States Patent no. 4,200,867. The examiner noted specifically that claim 2 of the '335 Patent was fully anticipated by Hill and that claim 1 was obvious by Hill and others. (Sender Decl., Ex. 8 at 103.) Claim 14 and all dependent claims (3-13 and 15-16) were, of course, also found to be obvious by Hill and others. (*Id.*)

Office Action in Reexamination, received February 2, 1993, Gussin distinguished the '335 Patent's pixel memory from the Hill color palette system. Gussin stated,

> In [my] claim 1, the pixel memory receives and stores digital *signals representing the actual color of the cursor. In Mr.* Hill's color palette systems, the pixel memory does not receive or store a signal representing the actual color of the cursor. Instead, Mr. Hill's pixel memory receives, and stores a color pointer, namely a signal representing the address of a color in the separate color memory of Hill's color palette systems.

(Sender Decl., Ex. 14 at 201-02.) Based, inter alia, on Gussin's distinction of his pixel memory, the PTO confirmed claims 1 and 3-16, as noted in the Office Action in Reexamination, mailed March 10, 1993. (*Id.*, Ex. 15 at 211.) Therein, the examiner stated that the referenced claims were allowed over the prior art since

> none of the references, Hill or [others], teach a "random access memory" wherein the "color and position of the cursor on the video monitor are written into said pixel memory." Hill does not store color data into the pixel memory, rather he uses the pixel memory to address a second memory which acts as the color palette.

(*Id.* at 222 (quoting '335 patent) (citation omitted).) The examiner's reliance on the pixel memory distinction was confirmed in the PTO's Supplemental Notice of Intent to Issue Reexamination Certificate, mailed July 28, 1993. (*Id.*, Ex. 20, at 265.) As noted in the Reexamination Interview Summary Form, filed April 1, 1993, claim 2 was also amended[12] after rejection upon reexamination to require the described pixel memory system. (*Id.*, Ex. 17 at 237.)

Based on these limitations, Nintendo argues that the '335 Patent does not read on the accused combination. (Def.'s Mem. Supp.

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[12] *See supra* note 10 for pertinent text of amended claim 2.

Summ. J. at 20.) The SNES, when used with Mario Paint, has no pixel memory that stores actual color data for each pixel of the image. (Ward Decl. ¶ 23.) Rather, the SNES stores, in a first memory, information (the so called pointers or addresses) used to select or locate actual color information in a separate, second color-palette memory. (*Id.*)

In response, Gussin argues that neither the patent's claims nor specification require the pixel memory to store actual color data. (Pl.'s Opp'n Mtn. Summ. J. at 12.) As to all claims other than claim 2, this is erroneous in light of Gussin's response to the order of reexamination and the examiner's clearly stated reasons for confirming patentability, both of which are quoted immediately supra. As to claim 2, the plain language and history of the agreed-upon amendment forecloses Gussin's argument.

Gussin also apparently contends, based on the declaration of attorney Brunton, that the PTO would have required additional limiting language to be included in the claims if the claims were to be limited as Nintendo suggests. (Pl.'s Opp'n Mtn. Summ. J. at 12-14; Brunton Decl. ¶ 12.) This is of no moment since the prosecution history, as set forth *supra*, clearly shows that Gussin by his own statements limited his claims to the single, pixel-memory system, as described *supra*. Again, it is clear that the public is entitled to rely on a patentee's statements to the PTO in determining the scope of claim coverage. *Haynes*, 8 F.3d at 1577-78; *Jonsson*, 903 F.2d at 817. Again, that Gussin never specifically amended claims 1 and 3-16 after his disavowments is of no moment. *Texas Instruments*, 988 F.2d at 1174-75; *Advanced Cardiovascular*, 26 U.S.P.Q.2d at 1307 n.5.

Based on an objective view of the clear language of the '335 Patent (including the amendment to claim 2) and of Gussin's statements to the PTO regarding exclusion of two-memory systems as taught in the prior art, the Court construes the patent-in-suit to be clearly limited to the pixel memory configuration described above. *See Haynes*, 8 F.3d at 1577-78; *Jonsson*, 903 F.2d at 817. As it appears beyond genuine controversy that the SNES/Mario Paint combination does in fact utilize a two-memory configuration with pointers or addresses and not color data stored in the pixel memory, the accused device does not infringe on the '335 Patent. Gussin's self-serving and conclusory declarations, which proffer

interpretations that would alter the clear public record, do not raise a genuine issue of fact. *Senmed*, 888 F.2d at 819 n.8; *Johnston*, 885 F.2d at 1580.

The Court therefore finds that claims 1 and 2 of the '335 Patent, properly construed based on the literal claim and specification language as well as the prosecution history, do not read on the accused device for the additional reasons described above. Thus, Nintendo's motion for summary judgment of noninfringement must be GRANTED on this third separate ground.

c. DEDICATED JOYSTICKS

Nintendo makes a similar argument with respect to the joystick configuration of Gussin's invention. Nintendo contends that the '335 Patent requires the presence of two joysticks, operating in "real time," to control the video art; it then argues that this configuration is absent from the accused combination. (Def.'s Mem. Supp. Summ. J. at 20-25.)

(i) CLAIM ONE

The literal language of claim 1 of the '335 Patent requires two separate joysticks,[13] one to control the position of the cursor on the video screen, and the other to control the color of the cursor. ('335 Patent, col. 9, lines 42-48.)

The prosecution history reveals that claim 1 was not so limited in the original patent application. (*See* Sender Decl., Ex. 2 at 51.)

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[13] Claim 1 states:

> A video art electronic system for drawing and coloring on a conventional color television monitor . . . comprising:
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> . . . .
>
> means including a first joystick to produce first digital signals representing the "X" and "Y" coordinates of a pixel position of a cursor on the video monitors; means including a second joystick to produce second digital signals representing the color of the cursor on the video monitor . . . .

('335 Patent, col. 9, lines 34-37, 42-48 (emphasis added).)

This application merely specified "means to produce" the two sets of digital signals described in the claim. (*Id.*) The February 25, 1988 Examiner's Amendment, which was issued in response to Gussin's application, indicates that the "means to produce" language was specifically rejected and amended to read "a first joystick" and "a second joystick." (*Id.*, Ex. 6 at 97.)

Additionally, during the reexamination of the '335 Patent in light of Hill, as described *supra*, Gussin clearly distinguished his invention by stating in his Patentee's Response that "Mr. Hill elected not to use a joystick to mix, adjust, store or select colors . . . . Thus, Mr. Hill's '867 patent points away from Gussin's claims." (*Id.*, Ex. 14 at 209.) Gussin thus distinguished Hill by showing that Hill used only a single joystick (to control cursor movement) whereas Gussin required two. (*See id.*)

Thus, the literal claim language of the '335 Patent as well as the prosecution history indicate that the Gussin invention requires two joysticks under claim 1. The Nintendo combination, in contrast, employs a single mouse in the place of the two joysticks. (Ward Decl. ¶ 20.)

Gussin argues, based on his own declaration, that claim 1 does not "state that the joysticks . . . must be 'single function', 'separate', 'independent' or 'dedicated'." (Pl.'s Opp'n Mtn. Summ. J. at 14.) This ignores and contradicts the claim language and prosecution history cited immediately *supra*. Gussin also argues that he distinguished the prior art by pointing out both that the '335 invention, unlike Burson, used a "draw/no draw" switch and that Gussin's design, unlike Hill's, had "pre-mixed colors." (Pl.'s Opp'n Mtn. Summ. J. at 14.) Assuming, arguendo, that Gussin's contentions are accurately supported by the record, they do not change the fact that Gussin also distinguished the prior art based on the joystick configuration. Gussin cannot reclaim that which he disavowed, and all distinctions (not just the ones he believes to be important) limit the coverage of his patent. *Haynes*, 8 F.3d at 1577; *Senmed*, 888 F.2d at 819 n.8.

(ii) CLAIM TWO

The literal language of claim 2 of the '335 Patent is not specifically limited to two joysticks; it does, however, require a

"first and second member positionably movable by an operatir [sic], the drawing and coloring being by way of real time positional and color correspondence of a cursor." ('335 Patent, col. 10, lines 4-7.) "Real time" is defined by the patentee as "drawing and coloring which occur essentially instantaneously with selected commands corresponding thereto." (*Id.*, col. 1, lines 33-35.) Gussin distinguished his invention by stating that the prior art did not allow real time drawing. (*Id.*, lines 31-32.)

During reexamination of the '335 Patent in light of Hill, discussed *supra*, Gussin again distinguished his invention's use of a moveable member for real-time command of colors from a system in which color selection is made from a color palette. (Sender Decl., Ex. 14 at 190; *id.*, Ex. 18 at 243.) In Gussin's invention, the position of the second moveable member directly corresponds to (or "commands") a fixed color. (*Id.*, Ex. 14 at 190; *id.*, Ex. 18 at 243.)

Thus, based on the claim and specification language, as well as the prosecution history, the Court construes claim 2 of the '335 patent to require two moveable members that allow for real-time drawing and color command based on the position of the second moveable member. Nintendo points out that, like Hill, the SNES/Mario Paint combination uses a color palette system that does not "command" colors based on the position of a second moveable member. (Ward Decl. ¶¶ 20-22.)

In response, Gussin argues that the "movable members" specified in claim 2 are not limited to joysticks. (Pl.'s Opp'n Mtn. Summ. J. at 15.) This is unavailing since Nintendo has not made that argument; rather, Nintendo has shown that claim 2 covers a system that employs two movable members with a specified relationship (real time drawing and color command based on the position of the second member). Nintendo has also shown that, even if the SNES mouse is viewed as two movable members, the position of the second member does not command a fixed color. (Ward Decl. ¶¶ 20-22.)

In conclusion as to the combined dedicated-joystick limitations, the accused device does not infringe claim 1 since it lacks the two joysticks specified therein and as made clear by the prosecution history. Additionally, the Nintendo product does not infringe claim 2 since it does not employ two moveable members with the

interrelationship as defined by the patent and the prosecution history.

Gussin again has proffered an interpretation that "would alter the undisputed public record," *Senmed*, 888 F.2d at 819 n.8, and has attempted to disavow his prior limitations and relinquishments, *Haynes*, 8 F.3d at 1577. Again, self-serving and conclusory declarations do not create genuine issues of fact. *Senmed*, 888 F.2d at 819 n.8; *Johnston*, 885 F.2d at 1580.

Therefore, the Court further finds that claims 1 and 2 of the '335 Patent, properly construed based on the literal claim and specification language and the prosecution history, do not read on the accused device for the additional reasons described above. Thus, Nintendo's motion for summary judgment of noninfringement must be GRANTED on this fourth separate ground.

d. DEDICATED DRAW SWITCH

Lastly, Nintendo argues that claims 1 and 2 of Gussin's patent require a dedicated "draw switch," which is absent in the SNES/Mario Paint system. (Def.'s Mem. Supp. Summ. J. at 26.)

The literal language of claims 1[14] and 2[15] of the '335 Patent

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[14] Claim 1 provides:

> A video art electronic system for drawing and coloring on a conventional color television video monitor . . . comprising: a draw switch having a first position for drawing and coloring on the video monitor and a second position for not drawing and coloring on the video monitor . . . .

('335 Patent, col. 9, lines 34-41 (emphasis added).)

[15] Claim 2 provides:

> A video art electronics system for drawing and coloring on a conventional color television video monitor . . . . said system further comprising: a draw switch having a first position for invoking said first mode of drawing and coloring on the video monitor and a second position for invoking said second mode or not drawing and coloring on the video monitor . . . .

require a draw switch that can be positioned for drawing or not drawing. ('335 Patent, col. 9, lines 38-41, col. 10, lines 30-34.) When "draw" is selected on this switch, the cursor draws lines on the monitor; when "not draw" is selected, the cursor moves over the screen without leaving a line. (Ward Decl. ¶ 10.)

The prosecution history again shows that Gussin distinguished his invention from the prior art on the basis of this switch. In his Amendment, received by the PTO December 2, 1987, discussed *supra*, Gussin remarked that all of his claims "include a switch that determines whether to draw or not to draw" and that "such structure is not found in the [prior] art." (Sender Decl., Ex. 5 at 93.)

The Court thus construes claims 1 and 2 to require the described two-position draw switch. Nintendo contends that, based on such a construction, the '335 Patent does not cover the accused device since such a switch is absent. (Def.'s Mem. Supp. Summ. J. at 27.) With the Nintendo system, the draw/no draw selection is made with the mouse, which Nintendo states is a multifunction (as opposed to two-position) control unit that also allows for selection of colors, shapes, and the like. (Ward Decl. ¶¶ 20-22.)

In a terse response to Nintendo's argument, Gussin contends that his patent does not require that the draw switch be "separate" or "dedicated." (Pl.'s Opp'n Mtn. Summ. J. at 15-16.) "Dedicated" or not, an objective view of the claim and the prosecution history reveals that a two-position switch is required ("a draw switch having a first position . . . and a second position"). Gussin also contends that Nintendo's mouse configuration embodies the required switch. (*Id.* at 19.) Again, since Nintendo's mouse does not have a "first position" and a "second position," it is not covered by the '335 Patent.

Gussin's declarations, which proffer interpretations that would alter the clear public record, again do not raise a genuine issue of fact. *See Haynes*, 8 F.3d at 1577-78; *Jonsson*, 903 F.2d at 817; *Senmed*, 888 F.2d at 819 n.8; *Johnston*, 885 F.2d at 1580.

The Court further finds that claims 1 and 2 of the '335 Patent, properly construed based on their literal language and prosecution history, do no read on the accused device for the additional reasons

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('335 Patent, col. 10, lines 1-3, 29-34 (emphasis added).)

described above. Thus, Nintendo's motion for summary judgment for noninfringement must be GRANTED on this fifth separate ground.

2. DOCTRINE OF EQUIVALENTS

Under the doctrine of equivalents, "infringement may be found if an accused device [1] performs substantially the same function [2] in substantially the same way [3] to achieve substantially the same result." *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538 (Fed. Cir. 1991) (citing *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950); *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 934 (Fed. Cir. 1987), *cert. denied*, 485 U.S. 961 (1988)). The doctrine is equitable in nature and involves balancing the competing policies of, on one hand, requiring patent claims to be particular and distinct so that competitors can avoid infringement, and on the other hand, protecting patentees from competitors who appropriate the essence of an invention while barely avoiding the literal language of the claim. *Id.* (citing *Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 856-57 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1068 (1989)).

It must be stressed that "application of the doctrine of equivalents is the exception, however, not the rule." *Id.* Overzealous application of the doctrine is problematic and must be avoided as, otherwise, "competitors will never know whether their actions infringe a granted patent." *Id.*; *see also International Visual Corp. v. Crown Metal Mfg. Co.*, 991 F.2d 768, 773-74 (Fed. Cir. 1993) (Lourie, J., concurring) (describing the doctrine as "much troubled" and counseling against its mechanical application).

Although the three-step formula for application of the doctrine of equivalents appears straightforward, it "does not mean that one can ignore claim limitations."[16] *Pennwalt*, 833 F.2d at 935. Thus, a patent owner may not "'under the guise of applying the doctrine of equivalents, erase a plethora of meaningful structural and functional limitations of the claim on which the public is entitled to

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[16] *See supra* note 3.

rely in avoiding infringement.'" *Id.* (quoting *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1532-33 (Fed. Cir. 1987)). And, as with literal infringement, "'it is . . . well settled that each element of a claim is material and essential, and that in order for a court to find infringement, the plaintiff must show the presence of . . . the substantial equivalent [of every element] in the accused device.'" *Id.* (first omission in original) (internal quotation marks omitted) (quoting *Perkin-Elmer*, 822 F.2d at 1532-33).

Lastly, to meet the requirement of being a substantial equivalent, as is required, "'the element substituted in the accused device for the element set forth in the claim must not be such as would substantially change the way in which the claimed invention is performed.'" *Id.* (emphasis added) (quoting *Perkin-Elmer*, 822 F.2d at 1532-33).

Gussin argues that the doctrine of equivalents should prevent Nintendo from prevailing on the instant motion. First, Gussin contends that determination of equivalence is "entirely factual, and is therefore for the jury, not the Court, for [sic] decide." (Pl.'s Opp'n Mtn. Summ. J. at 21.) As support, Plaintiff cites Ninth Circuit Model Jury Instruction 16.02.04, which merely sets forth the three basic Graver elements cited above. (*Id.*) This, of course, is nonsense. When there is no genuine issue of fact, the Court is perfectly capable of deciding equivalence on summary judgment. *E.g.*, *London*, 946 F.2d at 1541 ("Because the evidence presented showed that [the accused product] did not meet the limitations in the asserted claims, literally or equivalently, [Defendant] was properly entitled to summary judgment as a matter of law." (emphasis added)); *Johnston*, 885 F.2d at 1578 (affirming district court's finding, on summary judgment, of no literal or equivalent infringement).

Next, Gussin cites his own declaration as evidence of triable issues regarding equivalence. (Pl.'s Opp'n Mtn. Summ. J. at 21-25.) He runs through his familiar litany of arguments: the accused combination is not a computer and is thus the same as his invention, Nintendo's two-stage memory is the same as his pixel memory, the joysticks perform the same function as a mouse, and the mouse performs the same function as the draw switch. For at least the following reasons, these arguments are equally flawed under equivalence analysis.

First, Gussin consistently interprets the equivalence criteria far too broadly. He contends, for example, that the accused product infringes since "'the result is the same as with my claimed systems, the production of a user's drawing and painting on the screen of a color TV set.'" (Pl.'s Opp'n Mtn. Summ. J. at 21 (quoting Gussin Decl. ¶ 20).) By this reasoning, Gussin ignores all of the prior art (Hill, Burson, Tsunehiro) discussed above that also yielded the result of drawing and painting on a television screen. Additionally, and as discussed above, Gussin's self-serving and conclusory declaration does not create a genuine factual issue.

Second, in the guise of applying the doctrine of equivalents, Gussin ignores the plethora of significant claim limitations and distinctions, set forth *supra*, that estop him from claiming the expansive coverage and equivalency he asserts. His conclusory declaration also fails to set forth any genuine facts that, with these claim limitations in mind, could show substantial similarity to the protected claims. *See Lear Siegler, Inc. v. Sealy Mattress Co.*, 873 F.2d 1422, 1425 (Fed. Cir. 1989) (stating that, to raise a genuine issue of fact, the patent owner must introduce evidence of substantial identity of function, means, and result). Gussin's mere conclusions, for example, that a joystick is the same as a mouse and that there is a dispute as to words such as "computer," do not create material issues. *See Senmed*, 888 F.2d at 819 n.8 (where words are given their ordinary meaning in the specification and prosecution history, the inventor's "self-serving, post hoc opinion testimony" is of little if any significance).

Lastly, Gussin apparently contends that since Nintendo conceded the validity of the patent for purposes of the instant motion, file wrapper estoppel — for some unexplained reason — does not apply. Rather, it is clear that "unmistakeable assertions made . . . to the [PTO] in support of patentability, whether or not required to secure allowance of the claim, also may operate to preclude the patentee from asserting equivalency between a limitation of the claim and a substituted structure or process step." *Texas Instruments*, 988 F.2d at 1174.

In short, Gussin's arguments are no more availing with respect to the doctrine of equivalents than with respect to literal infringement, and he has presented no evidence that would favor applying this exceptional, equitable doctrine. Gussin simply may

not claim equivalency with subject matter he specifically relinquished during prosecution. Additionally, the Court finds that the differences between the Nintendo configuration and Gussin's invention, as set forth *supra*, are "not insubstantial," thus counseling against equivalency.

Based on the foregoing, the Court finds that this is not a proper case for application of the doctrine of equivalents and reiterates its findings, detailed *supra*, that no claims of the '335 Patent have been infringed.

C. DISPOSABLE ARGUMENTS

Gussin's makes two disposable arguments, of no avail, that will be touched on only briefly.

1. DR. WARD'S BIAS

Gussin frequently and throughout his opposition makes much of the fact that "Ward [is] a paid Nintendo 'expert' who has received over $ 380,000 from Nintendo over the past 5 years, and currently is under contract to Nintendo at a minimum monthly retainer of $ 8,000/month." (Pl.'s Opp'n Mtn. Summ. J. at 2, *see, e.g., id.* at 12; Pl.'s Statement of Genuine Issues ¶¶ 2, 7.) Plaintiff urges the Court to disregard the Ward declaration because of this bias.

Bias alone does not create a genuine factual dispute, nor does it otherwise entitle Plaintiff to a jury trial. *National Union Fire Ins. Co. v. Argonaut Ins. Co.*, 701 F.2d 95, 97 (9th Cir. 1983). In *National*, the "true thrust" of nonmovant's opposition was that the evidence submitted by the movant came from employees of the movant "whose interests [were] identical and biased." *Id.* In discarding this argument, the court stated that "neither a desire to cross-examine an affiant nor an unspecified hope of undermining his or her credibility suffices to avert summary judgment." *Id.*

This Court also notes that, by Plaintiff's reasoning, his own declaration would have to be disregarded on the same grounds: Who could be more self-interested in the outcome of patent litigation than the patent's owner/inventor?

2. GENERIC "ISSUE OF FACT" ARGUMENT

Gussin also argues that factual disputes over claim interpretation preclude summary judgment. Of course, genuine material factual disputes always preclude summary judgment; what is missing here is a genuine factual dispute. As noted above, "claim interpretation may be resolved as an issue of law by the court on summary judgment taking into account the specification, prosecution history or other evidence." *Johnston*, 885 F.2d at 1580.

Gussin contends that when "technical terms" are in dispute, a genuine issue of fact is presented. The authority that he relies on, however, requires that there be a genuine dispute or uncertainty as to the meaning of a claim term. Gussin fails to offer evidence, aside from conclusory affidavits, of any genuine dispute or uncertainty as to any technical term here. As stated in *Johnston*, "conflicting opinions on the meaning of a term which are merely conclusory do not create [the required] evidentiary conflict." *Id.*

At the hearing on this matter, Plaintiff's counsel repeatedly invoked the argument that this case raised the specter of a "technical dispute" and that, as such, summary judgment was inappropriate under *Palumbo v. Don-Joy Co.*, 762 F.2d 969 (Fed. Cir. 1985). Again, the Court disagrees. In short, the Court views the case at bench to be on all fours with *Johnston*, and is persuaded by the Federal Circuit's reasoning therein.

First, *Palumbo* clearly does not even attempt to establish a blanket rule that would proscribe summary judgment when a "technical" matter is being adjudicated. Were that the case, district courts would be hamstrung in applying Rule 56 in virtually all patent litigation.

Second, later Opinions from the Federal Circuit have disapproved of *Palumbo* and made it clear that "any broad statement in our precedent which could be read to say that a disagreement over the meaning of a term in a claim ipso facto raises an issue of fact is not the law of this circuit and may not be invoked or relied on as precedent." *Johnston*, 885 F.2d at 1580 (discussing *Palumbo*, 762 F.2d at 974; *Perini America, Inc. v. Paper Converting Machine Co.*, 832 F.2d 581, 584 (Fed. Cir. 1987)).

Thus, a mere dispute over the meaning of a term does

> not itself create an issue of fact. This is true even where the meaning cannot be determined without resort to the specification, the prosecution history or other extrinsic evidence provided upon consideration of the entirety of such evidence the court concludes that there is no genuine underlying issue of material fact.

Id. at 1579. Gussin therefore may not avert summary judgment by simply submitting a declaration in which he offers a contrary opinion as to the meaning of certain terms. Rather, there must be a genuine evidentiary conflict as to that term. *Id.* at 1579. For the reasons set forth repeatedly above, the Court has found that Plaintiff's declarations fail to raise the requisite genuine evidentiary conflict. Absent a genuine evidentiary dispute, "'claim interpretation in light of [insufficient] evidence remains a question of law.'" *Id.* (quoting *Howes v. Medical Components, Inc.*, 814 F.2d 638, 643 (Fed. Cir. 1987)).

Lastly, *Palumbo* is clearly distinguishable on its facts from the matter *sub judice*. In *Palumbo*, summary judgment was found to be inappropriate in part since the declaration of the inventor was found not to be conclusory. 762 F.2d at 976. Here, the Court has found exactly to the contrary. Additionally, the inventor's declaration in *Palumbo* was found to be a reasonable interpretation of the claim. *Id.* Here, the Court has determined that the interpretation proffered by Gussin is unreasonable since it is contrary to both the plain language of the patent claims and specification and since it conflicts with the clear prosecution history.

D. MISCELLANEOUS MATTERS

To the limited extent that paragraph nine of Plaintiff's Statement of Genuine Issues, etc.,[17] could be construed as a declaration

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[17] The referenced passage reads:

> Shouldn't the court refuse to give any weight to Mr. Sender's declaration of to the videotape that Nintendo filed as part of its motion because Nintendo has refused to permit Plaintiff to depose either Mr. Sender, (one of Nintendo's

requesting additional time for discovery under Federal Rule of Civil Procedure 56(f), that request is hereby DENIED for failure to comply with the procedural requirements of the rule and for failure to show any substantive justification for a continuance.

To the limited extent that any of the assertions in Plaintiff's Opposition to Defendant's Motion, etc., could be construed as a motion to strike, or evidentiary objections to, the Declaration of Stephen A. Ward or other declarations, they are hereby DENIED and OVERRULED, respectively.

Based on the Court's analysis and findings of noninfringement, Nintendo's evidentiary objections to the Declarations of Edward L. Gussin and James E. Brunton are hereby deemed MOOT.

V. CONCLUSION

Based on the foregoing, the Court ORDERS that Defendant Nintendo of America, Inc.'s Motion for Summary Judgment on Noninfringement be GRANTED.

SO ORDERED.

Dated: October 6, 1994

LOURDES G. BAIRD
United States District Judge

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lawyers), or the person(s) who created the videotape?

(Pl.'s Statement of Genuine Issues, etc. ¶ 9.)

JUDGMENT

It is hereby ORDERED, ADJUDGED, and DECREED that judgment be and hereby is entered in favor of Defendant Nintendo of America, Inc., and against Plaintiff Edward L. Gussin and that Plaintiff take nothing of Defendant.

SO ORDERED.

Dated: Oct. 6, 1994

LOURDES G. BAIRD
United States District Judge

(2)

FILED
NOV 30 1995
CLERK

No. 95-711

IN THE

Supreme Court of the United States

OCTOBER TERM, 1995

EDWARD L. GUSSIN,

Petitioner,

v.

NINTENDO OF AMERICA INC.

Respondent.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Whether the United States Court of Appeals for the Federal Circuit erred in affirming the District Court's grant of summary judgment for defendant/respondent on the alternative grounds that: 1) plaintiff/ petitioner failed to comply with the local rules of the United States District Court for Central District of California requiring him to identify genuine issues of fact that necessitated a trial; and 2) no genuine dispute existed, in any event, with respect to the patent claims in suit.

RULE 29.6
STATEMENT OF AFFILIATED COMPANIES

Pursuant to Rule 29.6 of this Court's rules, respondent states that: 1) Nintendo of America Inc. is a wholly owned subsidiary of Nintendo Company, Ltd., a Japanese corporation whose shares are traded on the Osaka and Tokyo stock exchanges; and 2) Nintendo of America Inc. owns a 51% interest in A/N Inc.

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LOCAL CIVIL RULES OF THE U.S. DISTRICT COURT FOR THE CENTRAL DISTRICT COURT OF CALIFORNIA

Rule 7.9: *Failure to File Required Papers.* Papers not timely filed by a party including any memoranda or other papers required to be filed under this rule will not be considered and may be deemed by the Court consent to the granting or denial of the motion, as the case may be.

Rule 7.14.2 *Statement of Genuine Issues of Material Fact by Opposing Party.* Any party who opposes [a summary judgment motion] shall serve and file with his opposing papers a separate document containing a concise "Statement of Genuine Issues" setting forth all material facts as to which it is contended there exists a genuine issue necessary to be litigated.

Rule 7.14.3 *Determination of Motion.* In determining any motion for summary judgment, the Court will assume that the material facts as claimed and adequately supported by the moving party are admitted to exist without controversy except to the extent that such material facts are (a) included in the "Statement of Genuine Issues" and (b) controverted by declaration or other written evidence filed in opposition to the motion.

RULES OF PRACTICE, UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Rule 47.6(b) *Nonprecedential opinions and orders* . - Opinions and orders which are designated as not citable as precedent are those unanimously determined by the panel at the time of their issuance as not adding significantly to the body of law. Opinions and orders so designated shall not be employed or cited as precedent. This rule does not preclude assertion of issues of claim preclusion, judicial estoppel, law of the case or the like based on a decision of the court rendered in a nonprecedential opinion or order.

No. 95-711

IN THE

Supreme Court of the United States

OCTOBER TERM, 1995

EDWARD L. GUSSIN,

Petitioner,

v.

NINTENDO OF AMERICA INC.

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

Respondent, Nintendo of America Inc. ("Nintendo"), submits this brief in opposition to the Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit of Petitioner Edward L. Gussin ("petitioner").[1]

STATEMENT OF THE CASE

Petitioner repeatedly misstates the bases on which summary judgment was granted and affirmed below. In a 36-page

[1] As cited herein, references to the Petition are designated "Pet.", references to the Petition's Appendices are designated "Pet. App." and references to the Excerpts of Record submitted to the Federal Circuit are designated "App. Rec.".

opinion rendered six months before *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (en banc), *cert. granted*, 116 S. Ct. 40 (Sept. 27, 1995) (No. 95-26), the district court first held that summary judgment was appropriate because the petitioner had failed to comply with the local rules of the Central District of California requiring him, on pain of dismissal, to identify genuine issues of material fact in response to Nintendo's motion for summary judgment. Pet. App. 16a - 17a.

As is typical across the Circuits, the local rules for the Central District of California require that a party opposing summary judgment file a "separate document containing a concise 'Statement of Genuine Issues' setting forth all material facts as to which it is contended there exists a genuine issue necessary to be litigated" and further provide that failure to comply would result in entry of summary judgment. Local Civil Rules of the Central District of California, Rules 7.14.3; 7.9; 7.14.2. Despite these rules, and Ninth Circuit case law affirming summary judgment for failure to comply with them, petitioner's opposition failed to set forth any specific facts allegedly in dispute with respect to claim construction or any other issue in this patent infringement suit.

Prior to argument of the summary judgment motion, the district court served the parties with a tentative opinion which, *inter alia*, pointed out petitioner's procedural failings. During argument, the district court repeatedly asked petitioner's counsel to identify any evidence sufficient to raise a disputed issue of material fact. App. Rec. 1447, 1450, 1466. Petitioner's counsel was unable to do so, arguing instead that summary judgment was inappropriate because unidentified "technical" matters had to be decided. App. Rec. 1449, 1452-53, 1463-64, 1467. The district court even offered to adjourn the argument to allow petitioner's counsel additional time to identify any disputed issue of material fact. Petitioner's counsel declined. App. Rec. 1456. Noting that petitioner's opposition fell "far short of what is contemplated by

the rules", the district court granted summary judgment on this first independent ground. Pet. App. 16a.

The Court of Appeals correctly affirmed the district court's dismissal on this basis, as one of two alternative grounds for affirmance, holding "[w]e agree with the district court that summary judgment was appropriate because Gussin's 'Statement of Genuine Issues of Material Fact' was deficient." Pet. App. 4a-5a.[2]

Even though petitioner had failed to specifically set forth any factual dispute in compliance with the local rules, the district court carefully proceeded to evaluate petitioner's arguments in opposition to the motion for summary judgment. As a result of its analysis, the district court granted summary judgment on petitioner's literal infringement claim on four additional and independent grounds because the accused Nintendo device did not contain any of four separate claim elements required by the asserted patent. Pet. App. 17a - 38a.[3]

As an alternative basis on which to affirm the grant of summary judgment, the Federal Circuit concurred with the district court's holding that there was no genuine issue of mate-

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[2] The Federal Circuit designated its opinion as not citable as precedent pursuant to Federal Circuit Rule 47.6(b). Such opinions are "those unanimously determined by the panel at the time of their issuance as not adding significantly to the body of law."

[3] The district court held that the explicit language of the claims, the specification, and the prosecution history each demonstrated that the asserted claims required a pixel memory that stores actual color data, and not just pointers to a separate, second color memory where the actual color data is stored. Pet. App. 23a - 27a. Because there was no genuine dispute that Nintendo's product did not contain a pixel memory that stored actual color data, the district court granted summary judgment of no literal infringement.The district court also granted summary judgment on the alternative bases that: 1) Nintendo's computer-based product was not a dedicated, hardware-based "video art electronic system" as required by the patent

rial fact regarding the claimed pixel memory element of the patent and stated that it did not need to reach the additional three grounds on which the district court granted summary judgment. Pet. App. 5a - 11a. The Federal Circuit cited its recent *Markman* decision to support its conclusion with respect to the pixel memory element that the "alleged conflicting opinions of both parties' experts do not create genuine issues of fact precluding summary judgment as to the meaning of the claims at issue." Pet. App. 6a. On the facts of this case, this conclusion was fully consistent with the Federal Circuit's pre-*Markman* precedent cited by the district court to the effect that conclusory expert declarations that conflict with the public patent record do not raise genuine issues of fact. See Pet. App. 18a-19a; 21a-22a; 26a-27a; 30a; 33a; 36a-37a, citing, e.g., *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579-80 (Fed. Cir. 1989) (although a genuine evidentiary conflict may be created pertinent to a claim's interpretation, "[c]onflicting opinions on the meaning of a term which are merely conclusory do not create such evidentiary conflict.").

The district court further ruled that petitioner could not rely on the doctrine of equivalents to expand the scope of his claims because, *inter alia*, he was, as a matter of law, estopped from expanding the literal scope of his claims. Pet. App. 21a-22a, 30a, 32a-35a; citing, *inter alia*, *Haynes Int'l, Inc. v. Jessop Steel Co.*, 8 F.3d 1573, 1579 (Fed. Cir. 1993) ("The legal standard for determining what subject matter was relinquished is an objective one, measured from the vantage point of what a competitor was reasonably entitled to conclude, from the prosecution history,

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claims; 2) the accused product did not have two "joysticks," or two "moveable members," the physical position of which directly controlled drawing and coloring, as required by the claims; and 3) the accused product lacked a two-position "draw switch" having a first position for drawing and a second position for not drawing as required by the claims. Pet. App. 19a-23a; 27a-35a.

that the applicant gave up to procure issuance of the patent."); *Jonsson v. Stanley Works*, 903 F.2d 812, 817 (Fed. Cir. 1990) (the prosecution history "limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain allowance.").

The Federal Circuit correctly affirmed the district court's holding that petitioner was estopped from relying on the doctrine of equivalents by his unequivocal and undisputed statements in the patent prosecution which limited the patent to systems with a specific type of pixel memory not present in the accused product. Pet. App. 10a-11a, citing *Southwall Technologies Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1579 (Fed. Cir. 1995).

Contrary to the Petition, the district court did not "disregard[ ] the disputed issues of fact identified by petitioner . . . [and] construe Gussin's patent claims as a matter of law" under the banner of the Federal Circuit's *Markman* decision. Pet. at 4. After pointing to petitioner's default in his obligation to demonstrate issues of disputed fact, the district court undertook its own analysis of the record and rendered its decision pursuant to pre-*Markman* cases. These cases allowed for the possibility that there might be disputed issues of fact with respect to claim construction that could preclude summary judgment. The district court examined petitioner's purported "evidence" and found that it did not raise a genuine issue of material fact:

> Gussin . . . argues that factual disputes over claim interpretation preclude summary judgment. Of course, genuine material factual disputes *always* preclude summary judgment; what is missing here is a genuine factual dispute . . . . Gussin contends that when "technical-terms" are in dispute, a genuine issue of fact is presented. The authority he relies on, however, requires that there be a *genuine dispute* or uncertainty as to the meaning of a claim term. Gussin fails to offer evidence, aside from conclusory affida-

> vits, of any genuine dispute or uncertainty as to any technical term here. As stated in *Johnston*, "conflicting opinions on the meaning of a term which are merely conclusory do not create [the required] evidentiary conflict."

Pet. App. 36a, (emphasis in original), citing *Johnston v. IVAC Corp.*, 885 F.2d 1574 (Fed. Cir. 1989).

The Federal Circuit similarly analyzed petitioner's proffered "evidence" and concluded (apart from petitioner's procedural default under the local rules) that the district court had properly granted summary judgment. *See, e.g.*, Pet. App. 9a (pointing out Gussin's incomplete quotation of the patent examiner's statement); Pet. App. 10a (noting that Gussin had miscited Nintendo's witnesses' declarations and depositions and concluding that there was no genuine issue of material fact necessitating trial).

SUMMARY OF ARGUMENT

The Federal Circuit affirmed the district court's grant of summary judgment on a first, independent ground that petitioner's opposition to the motion failed to comply with the local rules of the Central District of California, which explicitly warned that such a failure would result in a grant of summary judgment. As a case which was disposed of because of a willful, procedural default, this case does not merit review by this Court. The default was clear and undisputed under a routine local rule. Because this Court's disposition of *Markman* cannot affect the judgment entered for respondent on this ground, the Court should deny the Petition for a Writ of Certiorari.

Nor does the Federal Circuit's citation of its *Markman* decision in support of its alternative holding that the accused product lacked the requisite pixel memory element raise any Seventh Amendment issue that should be reviewed in this case. The Federal Circuit correctly affirmed the district court's pre-

Markman decision that no genuine dispute was presented by the record that required a trial.

REASONS TO DENY THE WRIT

The Federal Circuit's affirmance of summary judgment on the ground that petitioner had violated the district court's local rules is itself an independent and adequate basis for that decision. Although the Federal Circuit proceeded to examine the merits of the motion, that alternative holding was unnecessary to its affirmance of the district court judgment:

> The [district] court granted summary judgment in favor of Nintendo because Gussin's "Statement of Genuine Issues of Material Fact" was procedurally deficient and violated the court's local rules. In particular, the court found that Gussin "fail[ed] to specifically identify, in an intelligible manner, [the] facts asserted to be disputed and specific evidence in support of those assertions." . . . . We agree with the district court that summary judgment was appropriate because Gussin's "Statement of Genuine Issues of Material Fact" was deficient. Gussin simply asked nine vague questions that do not set forth evidence that raises a disputed issue of material fact.

Pet. App. 4a-5a (citation omitted).[4]

Petitioner does not argue that this sufficient basis for the Federal Circuit's affirmance presents any ground on which this

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[4] For example, Gussin queried the Court:

> Shouldn't the jury as trier of fact decide whether Dr. Ward [a Nintendo consultant and expert witness in this case] should be given any credibility since he admits he has been paid over $380,000 by Nintendo over the past five years, and presently earns at least $8,000 per month from Nintendo, whether he does any work or not?

App. Rec. 478.

Court should issue a writ of certiorari. In light of its fact-bound nature unique to the circumstances of this case, it indisputably does not. Because petitioner's procedural failings are an adequate and independent basis for the judgment below, no Seventh Amendment issue should be reached in this case. *Ashwander v. Tennessee Valley Auth.*, 297 U.S. 288, 346-47 (1936) (J. Brandeis concurring: "[I]f a case can be decided on either of two grounds, one involving a constitutional question, the other involving a question of statutory construction or general law, the Court will decide only the latter"). *See Escambia County, Florida v. McMillan*, 466 U.S. 48, 51 (1984) (*per curiam*) ("normally the Court will not decide a constitutional question if there is some other ground on which to dispose of the case"); *Globe Liquor Co. v. Four Roses Distillers Co.*, 404 U.S. 873 (1971) (denying certiorari because lower court ruling rested on independent and adequate state ground); *Alma Motor Co. v. Timken-Detroit Axle Co.*, 329 U.S. 129 (1946) (Court refused to decide the constitutionality of a federal statute because of the presence of nonconstitutional issues that alone might have constituted an adequate ground for deciding the case).[5]

Nor would the Federal Circuit's alternative ground for granting summary judgment, standing alone, present any Sev-

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[5] Petitioner wrongly suggests that the Court of Appeals and district court did not rely on petitioner's violation of the local rules as an independent ground for their decisions. Pet. 11, at n. 11 and accompanying text. The opinions of both the Court of Appeals and the district court explicitly hold that petitioner's procedural failing was a sufficient, independent basis for granting summary judgment. Pet. App. 4a; 16a-17a.

Petitioner's argument that he was unfairly surprised by the requirements of the district court's local rules was properly rejected by the Federal Circuit in light of the unambiguous requirements of the rules and the multiple opportunities petitioner was given to identify genuine issues of material fact. *See* pp. 1-3, *supra*; *Nilsson, Robbins, Dalgarn, Berliner, Carson & Worst v. Louisiana Hydrolec*, 854 F.2d 1538 (9th Cir. 1988) (local rule such as Central District of California Civil Rule 7.14.3 provides adequate notice that a party must identify genuine issues of fact and support it with evidentiary material). (Con't.)

enth Amendment issue for this Court's review. While the Federal Circuit cited *Markman*, it adopted the district court's analysis (prior to *Markman*) that there were no genuine issues with regard to the pixel memory element of the patent in any event. Pet. App. 6a, citing *Markman*, 52 F.3d at 983. *See Johnston v. IVAC Corp.*, 885 F.2d at 1579-80 ("Conflicting opinions on the meaning of a term which are merely conclusory" do not create a genuine evidentiary conflict precluding summary judgment); *Barmag Barmer Maschinenfabrik AG v. Murata Mach., Ltd.*, 731 F.2d 831, 836 (Fed. Cir. 1984) (same); *Senmed, Inc. v. Richard-Allan Medical Indus.*, 888 F.2d 815, 819 n.8 (Fed. Cir. 1989); *Haynes International, Inc. v. Jessop Steel Co.*, 8 F. 3d at 1578; *Jonsson v. Stanley Works*, 903 F.2d at 817. The Federal Circuit did not need to address the question of whether it had the right to resolve genuine disputes over the meaning of the claim terms in this case because, as the district court had noted, there were no such disputes presented: Gussin's proffered "evidence" was based on misstatements of the language of the patent and the prosecution history. Pet. App. 6a-9a.

Nor did the Federal Circuit resolve factual disputes with respect to the question of infringement, as the petition asserts. Pet. at 15. Again, the court explicitly examined petitioner's "evidence" and correctly affirmed the district court's holding that petitioner had misrepresented that evidence and that there was no genuine dispute as to how the accused product operated. Pet. App. 10a ("Gussin claims that Nintendo's expert witnesses admitted in their declarations and during depositions that the SNES stores actual color data. However, the declarations indicate instead that the pixel memory in the SNES device stores pointers rather than actual color data, and the deposition testi-

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Petitioner's failure to identify any disputed issue of material fact confirmed the district court's conclusion that Gussin's failure to comply with the local rules "appear[ed] to be caused by a lack of evidence in support of Plaintiff's complaint." Pet. App. 17a.

mony relied upon by Gussin is not inconsistent with those declarations.").

This is a simple case in which petitioner violated the district court's local rules and could not identify any genuine issue of fact necessitating a trial. It presents no Seventh Amendment issue for the Court's review, but rather a unique record applicable only to petitioner. On this record, there is no basis on which the question presented by the Petition could be addressed in this case. There is no basis to grant a writ of certiorari in this case, nor to defer the Petition pending this Court's decision in *Markman*. The Petition should immediately be denied.

CONCLUSION

For each of the reasons set forth herein, the Petition should be denied.

Respectfully submitted,

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No. 95-711

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

EDWARD L. GUSSIN,
Petitioner,

v.

NINTENDO OF AMERICA, INC.
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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REPLY BRIEF FOR PETITIONER

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December 11, 1995

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SUPREME COURT OF THE UNITED STATES
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REPLY BRIEF FOR PETITIONER

In this Seventh Amendment case, the United States Court of Appeals for the Federal Circuit held that the interpretation of a patent claim, as well as the resolution of conflicting testimony with respect to literal infringement and infringement under the doctrine of equivalents, may be deemed issues of "law" amenable to summary judgment. The petition for certiorari demonstrated that this case presents the same question as is raised in *Markman v. Westview Instruments, Inc.*, No. 95-26 (cert. granted Sept. 27, 1995). Indeed, this case extends the reasoning of the Federal Circuit in *Markman* beyond the context of claim interpretation to questions of infringement which this Court has held for more than a century are the province of the jury.

1. Respondent contends that the local rules for the United States District Court for the Central District of California provided "an alternative basis on which to affirm the grant of summary judgment." Opp. Cert. 3. Even if this were true, it would not affect the question presented, because alternative holdings are not dicta. *Woods v. Interstate Realty Co.*, 337 U.S. 535, 537 (1949).

More fundamentally, respondent's claim is not accurate. The District Court *itself* stated that "the Court will *not* rely solely on [the supposed procedural defect] to support its Order and will

evaluate Defendant's motion on its merits." Pet. App. 17a (emphasis added). The District Court could hardly have ruled otherwise, since it had denied Gussin leave to file an amended Statement of Genuine Issues of Material Fact on the ground that — in the Court's words — "I think it would be a futile act." C.A. App. 1468.[1]

Thus, in the end respondent is forced to acknowledged that "the district court carefully proceeded to evaluate petitioner's arguments in opposition to the motion for summary judgment." Opp. Cert. 3. Indeed, the bulk of the brief in opposition is devoted to a defense of the District Court's weighing of the evidence at the summary judgment stage. Respondent concedes that "the district court undertook its own analysis of the record." *Id.* at 5.

Nor can respondent deny that the Court of Appeals, although it noted the issue of the local rules, proceeded to decide the case on the merits. The Court of Appeals applied *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (in banc), to reject Gussin's arguments regarding claim interpretation. The Court of Appeals explained that *Markman* "held that claim construction is a question of law amenable to summary judgment. *The alleged conflicting opinions of both parties' experts do not create genuine issues of fact precluding summary judgment as to the meaning of the claims at issue.* Therefore, we reject Gussin's argument that summary judgment was inappropriate." Pet. App. 6a (emphasis added and citation to *Markman* omitted). The Court of Appeals stated that its interpretation of the patent claims under *Markman* "is sufficient

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[1] Respondent's reliance (Opp. Cert. 8 n.5) on *Nilsson, Robbins, Dalgarn, Berliner, Carson & Worst v. Louisiana Hydrolec*, 854 F.2d 1538 (9th Cir. 1988), proves why its argument has no force here. *Nilsson* involved a litigant that "repeatedly refused to conform to the Local Rules and Federal Rules of Civil Procedure." *Id.* at 1541. The violations included three entries of default, four orders for monetary sanctions for failure to comply with court orders and discovery requests, and numerous hearings on motions to compel. *Id.* at 1541-42. The party was given many opportunities to cure its misbehavior and exhibited only willful disobedience.

to cause us to affirm the trial court's grant of summary judgment that Nintendo's device does not literally infringe." *Id.* at 10a.

2. Respondent also argues that there were no genuine issues of disputed material fact precluding summary judgment under the conventional, non-*Markman* standard of review. But this suggestion is sheer speculation, for the Federal Circuit cut off the inquiry at the outset by relying on *Markman*. Pet. App. 5a-6a. The Court of Appeals did not simply adopt the District Court's analysis of the record. Instead, it undertook its *own* review in order to determine whether Nintendo's system infringed on Gussin's, "as properly construed." *Id.* at 6a. The court examined the patent specification, prosecution history, and extrinsic evidence — such as the declaration of Mr. Gussin (who had himself been qualified as an expert witness in previous patent litigation in which he was not a party). *Id.* at 6a-10a. *Nowhere* in the court's decision is there any indication that it would have reached the same result absent *Markman*.

Although respondent inaccurately labels Gussin's evidence as "conclusory," Opp. Cert. 9, it simply ignores the extensive evidence supporting Gussin, which is documented in the Petition for Certiorari at 3-10 & nn. 2-10. While we believe it is clear that there were extensive issues of disputed fact precluding summary judgment under the usual standard of Fed. R. Civ. P. 56, there is no reason for this Court to reach that question, because the Federal Circuit itself did not reach it. The Court of Appeals instead relied on *Markman* — and explicably extended it to fact-intensive questions of infringement. Whether the Court of Appeals' approach is consistent with the Seventh Amendment is squarely presented for this Court's review. If respondent wishes to pursue its summary judgment motion on different grounds, it can do so after this case is remanded to the Federal Circuit.

CONCLUSION

The petition for a writ of certiorari should be granted or, at minimum, held pending disposition of *Markman v. Westview Instruments, Inc.*, No. 95-26. If for any reason this Court did not reach the Seventh Amendment question in *Markman*, we submit that the instant case would be an excellent one in which to address that exceedingly important and recurring issue.

Respectfully submitted.

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